

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: August 28, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Monster Energy Company*

*v.*

*SS Vape Brands, Inc.*

—————  
Opposition No. 91255786  
—————

Aryeh Feinstein, Stephen J. Nataupsky, Lauren K. Katzenellegbogen, and Baraa Kahf of Knobbe, Martens, Olson & Bear, LLP for Monster Energy Company.

John Cyril Malloy, III, Meredith Frank Mendez, and W. John Eagan of Malloy & Malloy, P.L. for SS Vape Brands, Inc.

—————  
Before Bergsman, Greenbaum, and Hudis,  
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

SS Vape Brands, Inc (“Applicant”) seeks registration on the Principal Register of the mark ICE MONSTER and design, reproduced below, for “electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges,” in International Class 34.<sup>1</sup>

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<sup>1</sup> Application Serial No. 88606237 was filed on September 5, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based upon Applicant’s claim of first use anywhere and use in commerce since at least as early as July 11, 2016.



In its Application, Applicant describes the mark as follows:

The mark consists of the words “ICE MONSTER” made up of a design of carved ice appearing in the colors light blue and white.

The color(s) light blue and white is/are claimed as a feature of the mark.

Monster Energy Company (“Opposer”) filed a Notice of Opposition against the registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Opposer claimed ownership of 18 registered marks incorporating the term “Monster Energy” and nine registered marks consisting, in part, of the word “Monster” without the word “Energy” for, inter alia, nutritional supplements in liquid form or energy drinks and collateral merchandise.<sup>2</sup> For example,

- Registration No. 3044315 for the mark MONSTER ENERGY (in standard character form) for “nutritional supplements in liquid form, but excluding perishable

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<sup>2</sup> Opposer attached to its Notice of Opposition copies of its pleaded registrations printed from the USPTO Trademark Electronic Search System (TESS) showing the current status of and title to the registrations, thus, making them of record. Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1) (“A registration of the opposer ... pleaded in an opposition ... will be received in evidence and made part of the record if the opposition ... is accompanied by ... a current copy of information from the electronic database records of the Office showing the current status and title of the registration.” Therefore, it was not necessary for Opposer to introduce its pleaded registrations through a notice of reliance. 14 TTABVUE 19-193.

beverage products that contain fruit juice or soy, whether such products are pasteurized or not,” in International Class 5;<sup>3</sup>

- Registration No. 4036681 for the mark MONSTER ENERGY (in standard character form) for “non-alcoholic beverages, namely, energy drinks, excluding perishable beverage products that contain fruit juice or soy,” in International Class 32;<sup>4</sup>

- Registration No. 3057061 for the mark MONSTER ENERGY (in typed drawing form) for “fruit juice drinks having a juice content of 50% or less by volume that are shelf stable, carbonated soft drinks, carbonated drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not,” in International Class 32;<sup>5</sup>

- Registration No. 47165750 for the mark JUICE MONSTER (in standard character form) for “nutritional supplements in liquid form,” in International Class 5, and “non-alcoholic beverages, namely, energy drinks and drinks enhanced with

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<sup>3</sup> Registered January 17, 2006; renewed. Opposer disclaimed the exclusive right to use the word “Energy.”

<sup>4</sup> Registered October 11, 2011; renewed. Opposer disclaimed the exclusive right to use the word “Energy.”

<sup>5</sup> Registered February 7, 2006; renewed. Opposer disclaimed the exclusive right to use the word “Energy.” Prior to November 2, 2003, “standard character” marks were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”).

vitamins, minerals, nutrients, amino acids and/or herbs, but excluding perishable beverage products that contain fruit juice or soy,” in International Class 32;<sup>6</sup>

- Registration No. 4604556 for the mark PUNCH MONSTER (in standard character form) for “Nutritional supplements in liquid form; vitamin fortified beverages,” in International Class 5, and “non-alcoholic beverages, namely, energy drinks, energy drinks flavored with juice, fruit-flavored drinks, soft drinks, sports drinks, all enhanced with vitamins, minerals, nutrients, amino acids and/or herbs; all the foregoing goods exclude perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not, in International Class 32;<sup>7</sup>

- Registration No. 5018111 for the mark JAVA MONSTER (in standard character form) for “ready to drink coffee, iced coffee and coffee based beverages; ready to drink flavored coffee, iced coffee and coffee based beverages,” in International Class 30;<sup>8</sup> and

- Registration No. 4376796 for the mark MUSCLE MONSTER (in standard character form) for “nutritional supplements in liquid form,” in International Class 5, and “beverages, namely, soft drinks; non-alcoholic and non-carbonated drinks enhanced with vitamins, minerals, nutrients, proteins, amino acids and/or herbs; non-carbonated energy or sports drinks; all the foregoing goods exclude perishable

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<sup>6</sup> Registered April 7, 2015; Sections 8 and 15 declaration accepted and acknowledged.

<sup>7</sup> Registered September 16, 2014; Sections 8 and 15 declarations accepted and acknowledged.

<sup>8</sup> Registered August 9, 2016; Sections 8 and 15 declarations accepted and acknowledged.

beverage products that contain fruit juice or soy, whether such products are pasteurized or not,” in International Class 32.<sup>9</sup>

In addition, Opposer alleges prior common law rights in a family of “Monster” marks for “energy drinks, nutritional supplements, clothing, stickers, bags, helmets, hats, accessories, and numerous other products,”<sup>10</sup> and that its “MONSTER Marks have become famous identifiers of Opposer such that consumers have come to recognize a family of MONSTER Marks with which Opposer markets and sells its goods and services.”<sup>11</sup>

Applicant, in its Answer, denied the salient allegations of the Notice of Opposition.<sup>12</sup>

## **I. Preliminary Issues**

Before proceeding to the merits of the opposition, we address preliminary issues.

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<sup>9</sup> Registered July 30, 2013; Sections 8 and 15 declarations accepted and acknowledged. Opposer filed a combined Section 8 and 9 declaration on June 2, 2023.

<sup>10</sup> Notice of Opposition ¶ 2 (1 TTABVUE 19).

When we cite to the record, we refer to TTABVUE, the Board’s docketing system by docket entry and page number (e.g., 16 TTABVUE 34).

<sup>11</sup> Notice of Opposition ¶ 5 (1 TTABVUE 20).

<sup>12</sup> In its Answer, 4 TTABVUE 7, Applicant asserts the following (and only) affirmative defense: “Opposer’s claims are barred, in whole or in part, due to numerous third party registrations and marks incorporating the term “MONSTER” and/or design with a monster for the same or related goods and services in Classes 034 and 035 as Applicant’s Class 034 goods.” We construe Applicant’s purported defense, not as an affirmative defense, but only as an amplification of Applicant’s denials to the allegations in Opposer’s pleading (i.e., Opposer’s marks are weak and entitled only to a narrow scope of protection). *The Mars Generation, Inc. v. Carson*, 2021 USPQ2d 1057, at \*4 (TTAB 2021); *see also DeVivo v. Ortiz*, 202 USPQ2d 10153, at \*1 (TTAB 2020) (mere amplifications of the applicant’s denials not considered as separate affirmative defenses).

**A. Opposer's failure to cite to TTABVUE**

Since at least as early as 2017, the Board has been urging practitioners to cite to TTABVUE:

The parties should cite to the evidence in the trial record by referencing the TTABVUE entry and page number, and not attach previously-filed evidence to their briefs. For material or testimony that has been designated confidential, and which cannot be viewed on TTABVUE, the parties should include TTABVUE entry and page numbers for both the redacted and confidential versions.

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 801.01 (2017); *see also Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (“Because the Board primarily uses TTABVUE in reviewing evidence, the Board prefers that citations to material or testimony in the record that has not been designated confidential include the TTABVUE docket entry number and the TTABVUE page number.”).

Despite Opposer's counsel's extensive Board practice, it does not cite to TTABVUE when referring to the evidentiary record. The Board urges Opposer's counsel to use the Board's designated system of citation in all future cases, failing which the panel may suspend proceedings to have Opposer refile its brief citing to TTABVUE.<sup>13</sup>

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<sup>13</sup> Because Opposer introduced Sleiman's entire discovery deposition transcript thereby implying that the entire deposition is relevant and is akin to a testimony deposition, Opposer should have included a word index. *See* Trademark Rule 2.123(g)(3), 37 C.F.R. § 2.123(g)(3) (“Each deposition must contain a word index.”).

**B. Applicant's numerous objections**

Applicant has lodged numerous evidentiary objections.<sup>14</sup> An opposition proceeding is akin to a bench trial, with the Board as the trier of fact, and the Board is capable of assessing the proper evidentiary weight to be accorded admissible testimony and evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that we cannot rely on the evidence in the manner sought. We have considered all of the testimony and evidence properly introduced into the record. In doing so, we have kept in mind Applicant's objections and we have accorded whatever probative value the subject testimony and evidence merit. *See Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 1017); *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006). *See also Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) (where the objections refer to probative value rather than admissibility and the evidence that is subject to the objections is not outcome determinative, "we choose not to make specific rulings on each and every objection.").

Because the Board is capable of assessing the proper evidentiary weight accorded admissible testimony and evidence, parties are discouraged from maintaining objections that are not outcome-determinative. *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas, Inc.*, 77 USPQ2d 1492, 1495 (TTAB 2005) ("At the

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<sup>14</sup> Applicant's motion to strike portions of Opposer's testimonial declaration of Rodney Sacks and notices of reliance (29 TTABVUE); Applicant's motion to strike Opposer's testimony declaration of Rodney Sacks and notices of reliance (35 TTABVUE); and Applicant's statement of objections (46 TTABVUE).

oral hearing, pursuant to the Board's inquiry, counsel indicated that none of the objected-to evidence is outcome determinative. Several of the parties' objections merely reiterate what was raised in their motions to strike, and, thus, these evidentiary issues have already been handled above in deciding the various motions. ... The parties spent an inordinate amount of effort on evidentiary disputes. The gamesmanship during discovery, which then carried over into certain aspects of the trial phase, is breathtaking, and both sides are guilty of participating in this wasteful behavior.'). *Cf. Spiritline Cruises LLC v. Tour Mgm't Servs., Inc.*, 2020 USPQ2d 48324, at \*3 (TTAB 2020) (Board is "well equipped to assess the testimony and the degree of accuracy of any subsequent characterization of it without resorting to striking testimony or questions," denying opposer's objection and motion to strike a question of counsel, asked during a Rule 30(b)(6) discovery deposition, that had been submitted as trial evidence).

**C. Opposer's Securities and Exchange Commission (SEC) 10-K reports**

Opposer introduced copies of its 2002 – 2020 SEC 10-K reports posted on the Internet through a notice of reliance.<sup>15</sup> Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2) ("Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials

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<sup>15</sup> 14 TTABVUE 274-1254; 15 TTABVUE; and 16 TTABVUE.

were accessed and their source (e.g., URL) are provided.”). Opposer asserted, in its notice of reliance, that the SEC 10-K reports are “relevant generally to the strength and fame of Opposer’s MONSTER Marks, the similarity of Opposer’s and Applicant’s goods, and the variety of goods and services with which Opposer’s MONSTER Marks are used.”<sup>16</sup> In its notice of reliance, Opposer identified the “relevant” pages of the reports. Nevertheless, Opposer did not refer to any 10-K report in either its main brief or its reply brief.

First, we note that the probative value of the SEC 10-K reports posted on the Internet is limited. They can be used to demonstrate what the documents show on their face and may not be used to demonstrate the truth of what has been printed because they constitute hearsay. *See, e.g., Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co.*, 2022 USPQ2d 1242, at \*7 (TTAB 2022) (where “the parties seek to rely on the contents of the webpages for the truth of any assertion made therein, the statements in the websites are hearsay unless supported by testimony or other evidence.”), *civil action filed*, No. 1:23-cv-00227 (E.D. Va. Feb. 20, 2023); *Chutter, Inc. v. Great Mgm’t Grp., LLC*, 2021 USPQ2d 1001, at \*33 n.69 (TTAB 2021) (YouTube video stating number of “results” and “views” admissible only to show what has been printed, not the truth of what has been printed), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021); *Spiritline Cruises LLC*, 2020 USPQ2d 48324, at \*2 (Internet printouts and other materials properly introduced under a notice of reliance without

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<sup>16</sup> 14 TTABVUE 10.

supporting testimony considered only for what they show on their face rather than for the truth of the matters asserted).

Second, the information in the SEC 10-K reports is cumulative. As noted above, Opposer asserts that the SEC 10-K reports are “relevant generally to the strength and fame of Opposer’s MONSTER Marks, the similarity of Opposer’s and Applicant’s goods, the similarity of the trade channels for Opposer’s and Applicant’s goods, and the variety of goods and services with which Opposer’s MONSTER Marks are used.”<sup>17</sup> This is all covered in the testimony declaration of Dr. Bruce Isaacson, Opposer’s survey expert, who “was asked by counsel for [Opposer] to conduct a survey designed to measure whether the name ‘MONSTER ENERGY’ is famous,”<sup>18</sup> and the testimony declaration of Rodney Sacks, Opposer’s Chairman and Co-Chief Executive Officer.<sup>19</sup>

In view of the foregoing, and because Opposer did not refer to the SEC 10-K reports in its briefs, we follow Opposer’s lead and ignore the reports.

#### **D. Initial disclosures**

Opposer introduced a copy of Applicant’s initial disclosures through a notice of reliance.<sup>20</sup> Opposer did not explain the relevance of the initial disclosures in the notice of reliance. Likewise, Applicant introduced a copy of Opposer’s initial disclosures through a notice of reliance contending that they are “associated with the issues of

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<sup>17</sup> 14 TTABVUE 10.

<sup>18</sup> Isaacson Testimony Decl. ¶ 8 (24 TTABVUE 4).

<sup>19</sup> 25-27 TTABVUE. The Board posted the confidential portions of the Sacks declaration at 28 TTABVUE.

<sup>20</sup> 14 TTABVUE 9 and 195-198.

priority and likelihood of confusion.”<sup>21</sup> There is nothing in Opposer’s initial disclosures or Applicant’s initial disclosures that are remotely relevant to the issue of priority and likelihood of confusion. Neither party refers to the initial disclosures in their briefs. As we did with Opposer’s SEC 10-K reports, we follow the parties’ lead and ignore their initial disclosures.

**E. The Sleiman discovery deposition was improperly designated confidential**

Opposer introduced the discovery deposition transcript of Applicant’s cofounder and co-owner Sean Sleiman’s under seal designated confidential in its entirety.<sup>22</sup> However, only Exhibit 11, Applicant’s sales invoices, may be confidential.<sup>23</sup> Accordingly, pursuant to Trademark Rule 2.116(g), we treat only the aforementioned Exhibit 11 as confidential. Trademark Rule 2.116(g), 27 C.F.R. § 2.116(g) (“The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party.”).

Board proceedings are designed to be conducted in public and transparent to the public. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1416 n.21 (TTAB 2016) (it is intended that filings in Board proceedings be publicly available). Records of Board proceedings are open to public

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<sup>21</sup> 37 TTABVUE 4 and 26-31.

<sup>22</sup> 21 TTABVUE.

<sup>23</sup> Sleiman Discovery Dep., p. 68 and Exhibit 11 (21 TTABVUE 75 and 156-223). In light of Opposer’s extensive practice before the Board, we are disappointed that Opposer designated the entire the Sleiman deposition transcript as confidential inasmuch as there is no trade secret or commercially sensitive information except as noted above.

view and available for access by the public, subject only to the exception of limited submissions (exhibits, testimony portions of a brief, or other documents) which contain information which is truly confidential in nature. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458 (TTAB 2014) (contents of proceeding files publicly available); *Swiss Watch Int'l Inc. v. Federation of the Swiss Watch Indus.*, 101 USPQ2d 1731, 173 n.12 (TTAB 2012) (“[B]ecause proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential.”). Improper designation of materials filed in Board proceedings as confidential, as we have here, thwarts the intention of allowing the public the right to inspect judicial records and documents and is “an improper casual approach” to a party’s good faith requirement to designate only material that is truly confidential as “confidential.” *In re Violation of Rule 28(d)*, 635 F.3d 1352 98 USPQ2d 1144, 1149 (Fed. Cir. 2011) (counsel took an “improper casual approach” to marking the non-confidential version of the brief making it virtually incomprehensible). At final decision, improper designation makes it more difficult to make findings of fact, apply the facts to the law, discuss evidence, and write decisions that make sense when the facts may not be discussed. *Noble House Furnishings*, 118 USPQ2d at 1416 n.21. In granting a dispositive motion or at final decision, the Board needs to be able to discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board’s decisions. *Id.*

The fact that the Board's standard protective order is automatically entered upon commencement in the proceeding does not give a party unbridled authority to designate its filed submissions to the Board as protected. *THK Am. Inc. v. NSK Co. Ltd.*, 157 F.R.D. 637, 33 USPQ2d 1248, 1255, 1253 (N.D. Ill. 1993) (it is counsel's "place and responsibility" to ensure that the proper confidential designations are assigned); *Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1238 (TTAB 2017) ("A rule of reasonableness dictates what information should be [designated confidential and] redacted, and only in very rare instances should an entire submission be deemed confidential.").

Accordingly, the parties are allowed twenty days from the mailing date of this decision to refile the Sean Sleiman discovery deposition (20 and 21 TTABVUE) redesignating as non-confidential the overdesignated information and resubmitting a properly designated redacted copy for public view, failing which the Board will make the deposition transcript publicly available. *Azalea Health Innovations*, 125 USPQ2d at 1237–38 (where the parties designated as confidential the entirety of certain notices of reliance and testimony without submitting redacted copies for public viewing the Board ordered them to resubmit copies in which only truly confidential material was redacted, failing which the materials would be treated as part of the public record); *Swiss Watch Int'l Inc.*, 101 USPQ2d at 1736 (party submitted certain deposition testimony under seal, and was ordered to resubmit copies of testimony in which only truly confidential testimony was redacted); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 n.4 (TTAB

2011) (in cases where parties have excessively marked information as confidential the Board may require parties to resubmit those documents so that only truly confidential material is redacted), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014) (non-precedential).

## II. The Record

The record includes the pleadings, and under Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's application.<sup>24</sup> The parties introduced the testimony and evidence listed below:

### A. Opposers' testimony and evidence

1. Notice of reliance on Applicant's responses to Opposer's first set of interrogatories;<sup>25</sup>
2. Notice of reliance on Applicant's responses to Opposer's first requests for admission;<sup>26</sup>

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<sup>24</sup> Therefore, it was unnecessary for Applicant to introduce a copy of the file history of the application through a notice of reliance because the entire prosecution history is automatically of record. 37 TTABVUE 13-24. That Applicant introduced the prosecution history through a notice of reliance is puzzling because Applicant noted in its notice of reliance that the prosecution history of its application "forms part of the record of the proceeding without any action by the parties." 37 TTABVUE 2-3.

<sup>25</sup> 14 TTABVUE 200-214.

<sup>26</sup> 14 TTABVUE 216-225. A party may introduce only an admission to a request for admission through a notice of reliance. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120(k)(3)(i). A denial or statement that the responding party cannot respond to the request does not establish the truth or falsity of the assertion, but rather leaves the matter for proof at trial. *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 n.10 (TTAB 2008) (denials to requests for admission inadmissible because "unlike an admission (or a failure to respond which constitutes an admission), the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial."). As such, we consider only the admissions to the requests for admission.

3. Notice of reliance on Applicant's amended responses to Opposer's first set of interrogatories;<sup>27</sup>
4. Notice of reliance on Applicant's second amended responses to Opposer's first set of interrogatories;<sup>28</sup>
5. Notice of reliance on Applicant's third amended responses to Opposer's first set of interrogatories;<sup>29</sup>
6. Applicant's responses to Opposer's requests for production of documents;<sup>30</sup>
7. Notice of reliance on copies of printed publications;<sup>31</sup>

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<sup>27</sup> 14 TTABVUE 227-233.

<sup>28</sup> 14 TTABVUE 235-241.

<sup>29</sup> 14 TTABVUE 243-249.

<sup>30</sup> 14 TTABVUE 251-271. If no documents exist that are responsive to a document request, a party's response that no documents exist may be made of record. *See McGowen Precision Barrels, LLC v. Proof Research, Inc.*, 2021 USPQ2d 559, at \*5 n.6 (TTAB 2021) (written responses to requests for production of documents introduced through a notice of reliance are admissible solely for the purpose of showing that a party has stated that there are no responsive documents).

However, a party that has obtained documents from another party under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding; or Internet documents); or unless the documents have been authenticated by an admission or stipulation from the producing party. *See, e.g., Celesta GmbH v. Piano Factory Grp., Inc.*, 2019 USPQ2d 341894, at \*1 n. 4 & 5 (TTAB 2019) (unauthenticated documents produced in response to document requests not considered), *aff'd*, 11 F.4th 1363, 2021 USPQ2d 913 (Fed. Cir. 2021); *Syndicat Des Proprietaires Viticulteurs De Chateaufneuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1932 n.7 (TTAB 2013) (documents produced in response to a request for production of documents may not be introduced under notice of reliance); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 at n.8 (TTAB 2012) (produced documents cannot be introduced by notice of reliance alone); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1020-21 n.2 (TTAB 2011) (produced documents not considered because not admissible under notice of reliance).

<sup>31</sup> 17 TTABVUE.

8. Notice of reliance on copies of documents posted on the Internet consisting of excerpts from Opposer's website and third-party websites;<sup>32</sup>
9. Notice of reliance on the discovery deposition transcript of Sean J. Sleiman, Applicant's co-owner;<sup>33</sup>
10. Notice of reliance on copies of documents posted on the Internet, including the webpage from the 2019 NACS Show, two webpages relating to Socialbakers purportedly regarding Facebook monitoring, and a press release;<sup>34</sup>
11. Testimony declaration of Robert Vega, Chief Executive Officer and President of RJV Investigations, L.L.C., a private investigator, charged with taking photographs of various smoke shops, gas stations, and convenient stores he visited in California where he observed Opposer's MONSTER beverages being offered for sale;<sup>35</sup>
12. Testimony declaration of Dr. Bruce Isaacson, President of MMR Strategy Group, a marketing research and consulting firm, engaged to conduct a survey to measure whether MONSTER ENERGY is a famous mark;<sup>36</sup> and
13. Testimony declaration of Rodney Sacks, Co-Chief Executive Officers of Monster Beverage Corporation and its subsidiaries, including Opposer.<sup>37</sup>

## **B. Applicant's testimony and evidence**

1. Notice of reliance on a TESS database copy of Registration No. 5908565 for the mark GREEN STREET MONSTER for "cigarette

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<sup>32</sup> 18-19 TTABVUE.

<sup>33</sup> 20 and 21 TTABVUE. The deposition transcript is designated confidential and posted on 21 TTABVUE. Some of the exhibits are publicly available at 20 TTABVUE.

<sup>34</sup> 22 TTABVUE .

<sup>35</sup> 23 TTABVUE.

<sup>36</sup> 24 TTABVUE.

<sup>37</sup> 25-27 TTABVUE (public); 28 TTABVUE (confidential).

holders; cigarette rolling machines; tobacco grinders,” in International Class 34;<sup>38</sup>

2. Notice of reliance on a TESS database copy of Registration No. 5312482 for the mark DM DRIP MONSTER and design for “electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges,” in International Class 34;<sup>39</sup>
3. Notice of reliance on Opposer’s responses to Applicant’s first set of interrogatories;<sup>40</sup>
4. Notice of reliance on Opposer’s supplemental response to Applicant’s first set of interrogatories;<sup>41</sup>
5. Notice of reliance on Opposer’s amended response to Applicant’s first set of interrogatories;<sup>42</sup>
6. Testimony declaration of Sean Sleiman, Applicant’s co-founder/co-owner;<sup>43</sup> and
7. Notice of reliance on copies of documents posted on the Internet.<sup>44</sup>

**C. Opposer’s rebuttal testimony and evidence**

1. Rebuttal declaration of Rodney Sacks;<sup>45</sup> and
2. Notice of reliance on copies of third-party registrations.<sup>46</sup>

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<sup>38</sup> 37 TTABVUE 8.

<sup>39</sup> 37 TTABVUE 10-11.

<sup>40</sup> 37 TTABVUE 33-54 and 69-70.

<sup>41</sup> 37 TTABVUE 56-66 and 69-70.

<sup>42</sup> 37 TTABVUE 72-80.

<sup>43</sup> 38 TTABVUE.

<sup>44</sup> 39 TTABVUE.

<sup>45</sup> 41 TTABVUE.

<sup>46</sup> 40 TTABVUE.

### III. Entitlement to a statutory cause of action

“Entitlement to a statutory cause of action, formerly referred to as ‘standing’ by the Federal Circuit and the Board, is an element of the plaintiff’s case in every inter partes case.” *Illyrian Import, Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, at \*17 (TTAB 2022) (citations omitted). To establish entitlement to a statutory cause of action under Section 13 of the Trademark Act, Opposer must demonstrate (1) an interest falling within the zone of interests protected by the statute; and (2) a reasonable belief in damage proximately caused by registration of the applied-for mark. *See Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at \*2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 134 S. Ct. 1377, 188 L. Ed. 2d 392, 109 USPQ2d 2061, 2068-69 (2014)).

Evidence made of record of Opposer’s use and registration of its MONSTER and MONSTER ENERGY marks establish that it is entitled to oppose the registration of Applicant’s mark.<sup>47</sup> *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations “suffice to establish ... direct commercial interest”; a belief in likely damage can be shown by establishing a direct commercial interest); *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at \*6 (TTAB

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<sup>47</sup> 1 TTABVUE 39-177; Sacks Testimony Decl. ¶ 3 (25 TTABVUE 3) (“[Opposer] began using

its MONSTER™, MONSTER ENERGY®,  and M MONSTER ENERGY® marks in 2002 when it launched its MONSTER line of drinks, and has continued to use MONSTER-inclusive marks in connection with beverages, apparel, accessories, and numerous other products and services since that time.”).

2020) (pleaded registrations establish statutory entitlement to bring opposition); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that plaintiff uses its mark “is sufficient to support [plaintiff’s] allegations of a reasonable belief that it would be damaged ...”); *Barbara’s Bakery v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (opposer’s entitlement to opposition established by pleaded registration being of record and non-frivolous likelihood of confusion claim).

If we understand Applicant’s argument, Applicant contends that Opposer failed to establish its entitlement to a statutory cause of action because it has failed to prove it will be damaged by the registration of Applicant’s mark.

There is also no evidence concerning how the alleged confusion has impact or will impact Opposer’s reputation or commercial success. Therefore, Opposer’s assertion that “[a]ny mistaken association between Applicant’s e-cigarette liquid and other vape-related products and Opposer and its authorized products will harm Opposer because this will directly affect Opposer’s control over its business reputation and goodwill” is conclusory and thus insufficient to demonstrate a reasonable belief of damage. TTABVUE 25 at p. 57. *See Vital Pharms., Inc.* [v. PHD Mktg.] 2020 U.S. Dist. LEXIS 208394, at \*22-23 [C.D. Cal. Nov. 6, 2020] (finding plaintiffs’ assertions that defendant “will continue to suffer tremendous loss of goodwill to its BANG brand” and “will loss [sic] control of the reputation of the BANG brand”, are “conclusory and thus insufficient to demonstrate a likelihood of irreparable harm” necessary to grant a preliminary injunction). Accordingly, Opposer has failed to meet its burden to prevail in this Opposition.<sup>48</sup>

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<sup>48</sup> Applicant’s Brief, pp. 20-21 (44 TTABVUE 21-22).

As noted above, Opposer must demonstrate (1) an interest falling within the zone of interests protected by the statute; and (2) a reasonable belief in damage proximately caused by registration of the applied-for mark. There is no requirement that actual damage be pleaded or proved to prove entitlement to a statutory cause of action. *See, e.g., Blackhorse v. Pro-Football, Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011) (no requirement that actual damage be pleaded and proved to establish entitlement to a statutory cause action); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (plaintiff does not have to prove claims or “actual damage” to establish standing). Here, proof of Opposer’s pleaded registrations is sufficient to demonstrate its entitlement to bring a claim under Section 2(d) of the Trademark Act. *Made in Nature v. Pharmavite*, 2022 USPQ2d 557, at \*7 (TTAB 2022); *New Era*, 2020 USPQ2d 10596, at \*6.

#### **IV. Priority**

##### **A. Pleded registrations**

The same pleaded registrations, which Applicant has not counterclaimed to cancel, establish that priority is not an issue as to the marks and the goods covered by the registrations. *See Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1469 (TTAB 2016) (citing *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d. 1400, 182 USPQ 108, 110 (CCPA 1974)).

Applicant argues that because Opposer neither uses, nor registered, its MONSTER ENERGY or MONSTER marks in connection with “electronic cigarette liquid (e-liquid),” Applicant has priority for e-liquids and, therefore, the opposition

should be dismissed because Opposer does not have priority.<sup>49</sup>

As noted immediately above, by introducing its pleaded registrations that Applicant has not counterclaimed to cancel, Opposer has priority for the goods listed in those registrations. Therefore, priority is not an issue in this case. The issue before us is whether Applicant's ICE MONSTER and design mark for "electronic cigarette liquid (e-liquid)" so closely resembles Opposer's MONSTER ENERGY and MONSTER marks for nutritional supplements in liquid form, energy drinks, and collateral merchandise as to be likely to cause confusion. In other words, it is incumbent upon Opposer to prove, in addition to any other likelihood of confusion factors, the parties' marks are similar and the parties' goods are related so that consumers will mistakenly believe that the products emanate from the same source.

### **B. Family of marks**

"Although the USPTO may register several individual marks comprising a family element together with one or more other elements, it does not register 'families' of prefixes, suffixes, or other components of a mark." *New Era Cap Co.*, 2020 USPQ2d 10596, at \*6-7. "Thus, an opposer relying on a family of marks is relying on common law rights in the alleged family." *Id.* at \*7. "The burden of proving a family of marks falls with Opposer, the party asserting the existence of the family." *Id.*

As defined in *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460,

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<sup>49</sup> Applicant's Brief, p. 20 (44 TTABVUE 21).

18 USPQ2d 1889, 1891-92 (Fed. Cir. 1991):

[a] family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods . . . . Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin. “Neither the mere intention to create a family of marks, nor ownership of multiple registrations containing the family term, is sufficient in and of itself to establish that a party owns a family of marks.” *New Era*, 2020 USPQ2d 10596 at \*7 (citations omitted). In order to prove ownership of a family of marks, Opposer must establish:

“[F]irst, that prior to the entry into the field of the opponent’s mark, the marks containing the claimed ‘family’ feature or at least a substantial number of them, were used and promoted together by the proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the ‘family’ feature; and second, that the ‘family’ feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party’s mark).”

*Id.* (quoting *Marion Labs. Inc. v. Biochemical Diagnostics Inc.*, 6 USPQ2d 1215, 1218-19 (TTAB 1988) (internal quotations omitted)). *See also TPI Holdings Inc. v. Trailertrader.com, LLC*, 126 USPQ2d 1409, 1420 (TTAB 2018) (proof of a family of marks requires proof of prior use of marks that share the common characteristic or

family “surname,” that the family surname is distinctive, and that the “marks were used in advertising or sales so as to create common exposure to and recognition by purchasers of the common characteristic as indicating origin.”) (citing *Wise F & I, LLC. v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1109 (TTAB 2016)). Opposer “must prove the existence of [a MONSTER] family of marks prior to any date Applicant can rely upon for purposes of priority.” *New Era*, 2020 USPQ2d 10596 at \*7.

While Opposer asserts in its brief common law rights in its various MONSTER and MONSTER ENERGY marks, Opposer makes no effort to prove priority based on a family of marks. For example,

Opposer Monster Energy Company (“Opposer” or “Monster”) began using its MONSTER®, MONSTER ENERGY®, and M MONSTER ENERGY® marks when it launched its original Monster Energy® line of drinks in 2002. [Opposer’s] family of MONSTER-inclusive marks has grown to include many other marks that contain MONSTER.<sup>50</sup>

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Since 2002, [Opposer] has consistently used its MONSTER Marks to identify its beverage product line.<sup>51</sup>

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[Opposer] has used and promoted its MONSTER Marks together in a manner whereby the consuming public has come to associate the common characteristic—the term MONSTER—with [Opposer]. The term MONSTER is distinctive, and [Opposer] has used the MONSTER Marks in advertising and sales so as to create common exposure to, and recognition by purchasers, of the common

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<sup>50</sup> Opposer’s Brief, p. 1 (42 TTABVUE 9).

<sup>51</sup> Opposer’s Brief, p. 5 (42 TTABVUE 13).

term other than to state in the introduction section “the MONSTER Marks appear together in the same advertisements and at the point-of-sale (e.g., store displays, refrigerator racks, etc.)” The MONSTER Marks are regularly displayed together, ...

In short, the MONSTER Marks comprise a *family* of marks that share the common term MONSTER.<sup>52</sup>

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Further, in addition to its federal trademark registrations, [Opposer] owns common law rights in its MONSTER Marks in connection with apparel, beverage ware, bags, and accessories (among other goods) as a result of its use and promotion of the MONSTER Marks in connection with these goods as set forth above since long before Applicant filed Applicant’s Application. See Section III.A., *supra*.<sup>53</sup>

Assuming arguendo, Opposer has a family of MONSTER marks, there is no particular evidence or testimony about the timing of when such a family was established.<sup>54</sup> See *U.S. v. Hayter Oil Co.*, 51 F.3d 1265, 1269 (6th Cir. 1995) (“[I]t is not our function to craft an appellant’s arguments.”) (citation omitted); *U.S. v. Dunkel*, 927 F.2d 955, 956 (7th Cir. 1991) (stating “[a] skeletal ‘argument,’ really nothing more than an assertion, does not preserve a claim [for appellate review] . . . Judges are not like pigs, hunting for truffles buried in briefs.”) (citations omitted); *Clintec Nutrition Co. v. Baxa Corp.*, 988 F.Supp. 1109, 44 USPQ2d 1719, 1723 n.16

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<sup>52</sup> Opposer’s Brief, pp. 6-7 (42 TTABVUE 14-15).

<sup>53</sup> Opposer’s Brief, pp. 32-33 (42 TTABVUE 40-41).

<sup>54</sup> It certainly would not be 2002, when Opposer first began using its MONSTER and MONSTER ENERGY marks because that would mean consumers perceived Opposer’s family of MONSTER marks simultaneously with Opposer’s first use of its MONSTER and MONSTER ENERGY marks.

(N.D. Ill. 1997) (a court will not pour over the documents to extract the relevant information).

Opposer failed to prove the existence of a family of MONSTER marks prior to Applicant's July 2016 date of first use. Therefore, due to lack of supporting evidence, we give Opposer's family of marks arguments no further consideration. Thus, we analyze Opposer's likelihood of confusion claim based on the similarities or dissimilarities between Opposer's MONSTER and MONSTER ENERGY marks and goods and services and Applicant's ICE MONSTER mark and goods, but not with respect to Opposer's family of marks.

## **V. Likelihood of confusion**

We base our determination under Section 2(d) on an analysis of all the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). “Whether a likelihood of confusion exists between an applicant’s mark and a previously registered mark is determined on a case-by-case basis, aided by application of the thirteen *DuPont* factors.” *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1689 (Fed. Cir. 2018). “In discharging this duty, the thirteen *DuPont* factors ‘must be considered’ ‘when [they] are of record.’” *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162 (Fed.

Cir. 2019) (quoting *In re Dixie Rests. Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) and *DuPont*, 177 USPQ at 567).

Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. See *In re Charger Ventures LLC*, 64 F.4th 1375, 2023 USPQ2d 451, at \*4 (Fed. Cir. 2023) (“In any given case, different *DuPont* factors may play a dominant role and some factors may not be relevant to the analysis.”); *Citigroup Inc. v. Cap. City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011). “Not all *DuPont* factors are relevant in each case, and the weight afforded to each factor depends on the circumstances. Any single factor may control a particular case.” *Stratus Networks, Inc. v. UBTA-UBET Commc’ns Inc.*, 955 F.3d 994, 2020 USPQ2d 10341, at \*3 (Fed. Cir. 2020) (citing *Dixie Rests.*, 41 USPQ2d at 1533).

“Each case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386, 387 (CCPA 1973). “Two key factors in every Section 2(d) case are the first two factors regarding the similarity or dissimilarity of the marks and the goods or services, because the ‘fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.’” *In re Embiid*, 2021 USPQ2d 577, at \*10 (TTAB 2021) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976)). See also *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (“The likelihood of confusion analysis considers all *DuPont* factors for which there is record evidence but ‘may focus ... on dispositive factors, such as similarity of the marks and

relatedness of the goods.”) (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004).

**A. The strength of Opposer’s MONSTER ENERGY and MONSTER marks**

Opposer alleges that its MONSTER marks have become famous<sup>55</sup> and argues, in its brief, that its marks are famous.<sup>56</sup> Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame, the fifth *DuPont* factor, enables Opposer to expand the scope of protection afforded its pleaded marks by adducing evidence of “[t]he fame of the prior mark (sales, advertising, length of use).” Under the fifth factor, likelihood of confusion fame is not “an all-or-nothing measure.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (Fed. Cir.

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<sup>55</sup> Notice of Opposition ¶ 5 (1 TTABVUE 20) (“By virtue of Opposer’s continuous and substantial use, the MONSTER Marks have become famous identifiers of Opposer such that consumers have come to recognize a family of MONSTER Marks with which Opposer markets and sells its goods and services.”).

<sup>56</sup> Applicant’s Brief, p. 18 (42 TTABVUE 26) (“As a result of [Opposer’s] extensive marketing and promotion ... its MONSTER Marks have become famous.”).

2017). It “varies along a spectrum from very strong to very weak.” *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)).

To determine a mark’s place on the spectrum of from very strong to very weak, we consider its inherent or conceptual strength, based on the nature of the mark itself, and its commercial strength, based on its marketplace recognition. *See Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 2023 USPQ2d 737, at \*4 (Fed. Cir. 2023); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength.”); *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017); *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength); *Tea Bd. of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (market strength is the extent to which the relevant public recognizes a mark as denoting a single source); J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 11:83 (5th ed. March 2023 Update) (“The first enquiry is for conceptual strength and focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

We may measure commercial strength (or fame) indirectly, by volume of sales and advertising expenditures and factors such as length of use of the mark, widespread critical assessments, notice by independent sources of the goods or services identified by the mark, and general reputation of the goods or services. *Weider Publ'ns, LLC v. D&D Beauty Care Co.*, 109 USPQ2d 1347, 1354 (TTAB 2014).

**1. The inherent or conceptual strength of Opposer's MONSTER marks.**

The MERRIAM WEBSTER DICTIONARY ([merriam-webster.com](http://merriam-webster.com)) (accessed August 3, 2023) defines the word "Monster" as, inter alia,

**1 a** : an animal of strange or terrifying shape

a mythical monster

a sea monster

... visualize this scaleless monster, eight or nine feet long, sprawling in the shade by the side of the mud pools ...—W. E. Swinton

**b** : one unusually large for its kind

That truck is a monster.

That's why I was born in my grandmother's house—a grand, brick Federal monster of a house.—John Irving

**2 a** : an animal or plant of abnormal form or structure

**b** : one who deviates from normal or acceptable behavior or character

an immoral monster

**3** : a threatening force

the same monster—Destiny ... that rolls every civilization to doom—W. L. Sullivan

4 : something monstrous

especially : a person of unnatural or extreme ugliness,  
deformity, wickedness, or cruelty

a cruel monster of a father

5 : one that is highly successful

That movie was a monster at the box office.<sup>57</sup>

Based on the dictionary definitions alone, the word “Monster” is an arbitrary term when used in connection with nutritional supplements in liquid form, energy drinks, and associated collateral merchandise. *See Nautilus Grp., Inc. v. Icon Health & Fitness, Inc.*, 372 F.3d 1330, 71 USPQ2d 1173, 1180 (Fed. Cir. 2004) (defining an arbitrary mark as “a known word used in an unexpected or uncommon way” and observing that such marks are typically strong because they naturally serve to identify a particular source of a product or service); *Monster Energy v. Lo*, 2023 USPQ2d 87, at \*21 (TTAB 2023) (finding MONSTER ENERGY arbitrary and hence conceptually strong for restaurant services).

However, the sixth *DuPont* factor allows Applicant to contract that scope of protection by adducing evidence of “[t]he number and nature of similar marks in use on similar goods.” *DuPont*, 177 USPQ at 567.

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<sup>57</sup> The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re S. Malhotra & Co. AG*, 128 USPQ2d 1100, 1104 n.9 (TTAB 2018); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

Although Applicant did not proffer evidence of third-party use of other MONSTER marks, it introduced copies of two registrations consisting of the word “Monster” in International Class 34:

- Registration No. 5908565 for the mark GREEN STREET MONSTER for “cigarette holders; cigarette rolling machines; tobacco grinders,” in International Class 34,<sup>58</sup> and

- Registration No. 5312482 for the mark DM DRIP MONSTER and design for “electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges,” in International Class 34.<sup>59</sup>

There are two problems with Applicant’s third-party registration evidence. First, the *DuPont* factor at issue is the strength of Opposer’s MONSTER ENERGY and MONSTER marks, not Applicant’s mark. Applicant did not introduce registrations for goods that show Opposer’s marks have become diluted with respect to Opposer’s goods. See *TAO Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1058 (TTAB 2017) (third party registrations in unrelated fields “have no bearing on the strength of the term in the context relevant to this case.”).

Second, assuming arguendo that Applicant introduced registrations for Opposer’s goods or goods related thereto, “extensive evidence of third-party use and

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<sup>58</sup> 37 TTABVUE 8.

<sup>59</sup> 37 TTABVUE 10-11. However, Sean Sleiman testified that he does not believe that company is in existence now. Sleiman Discovery Dep., p. 141 (21 TTABVUE 148).

registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established.” *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). Third-party registrations, in particular, are relevant to prove that some segment of a mark that both parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the segment is relatively weak. *Juice Generation*, 115 USPQ2d at 1675. *See also Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”). However, unlike cases in which extensive evidence of third-party use and other evidence in the record was found to be “powerful on its face” inasmuch as “a considerable number of third parties use [of] similar marks was shown,” *Juice Generation*, 115 USPQ2d at 1674, Applicant has presented two irrelevant third-party registrations, well short of the volume of evidence found convincing in *Jack Wolfskin* and *Juice Generation*. In other words, these two registrations for goods different than Opposer’s goods do not prove that “Monster” has a normally understood and well-recognized descriptive or suggestive meaning for Opposer’s goods.

## **2. Commercial strength**

We find that Opposer’s MONSTER mark for beverages is commercially strong, if

not famous. There is no need to recount the evidence of the commercial strength of Opposer's MONSTER mark in connection with beverages inasmuch as the evidence is persuasive and Applicant does not present a cogent argument contesting the commercial strength of Opposer's marks for beverages.<sup>60</sup> Moreover, Opposer introduced the testimony declaration and expert report of Dr. Bruce Isaacson, President of MMR Strategy Group, a marketing research and consulting firm, who conducted a survey to measure whether the name MONSTER ENERGY is famous.<sup>61</sup>

We set forth his conclusion below:

30. The data show that 87.7% of respondents indicated that they had seen or heard of MONSTER ENERGY before today used by a company as a name for a beverage, compared with 1.5% for the control name, MAMMOTH POWER. The measures for other names in the survey ranged from 36.9% for JOLT COLA to 99.0% for DIET COKE.

31. As described above, my survey included a control name, MAMMOTH POWER. The net measure for the fame of MONSTER ENERGY is 86.2%, which was calculated by subtracting 1.5% from 87.7%. In my experience, this measure is sufficiently high to indicate that MONSTER ENERGY is famous.

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<sup>60</sup> See Sacks' Testimony Decl. (25-27 TTABVUE) (public) and 28 TTABVUE (confidential); Isaacson Testimony Decl. 24 TTABVUE.

As noted above, Applicant lodged numerous objections to the exhibits attached to the Rodney Sacks declaration. Nevertheless, Mr. Sacks' testimony alone without the exhibits is sufficient to prove that Opposer's MONSTER ENERGY and MONSTER marks for beverages are commercially strong.

In addition, Sean Sleiman conceded that Opposer's "advertising for Monster is extensive" and, somewhat facetiously that "50 million Americans" drink MONSTER beverages. Sleiman Discovery Dep., pp. 30 and 31 (21 TTABVUE 37 and 38).

<sup>61</sup> Isaacson Testimony Decl. ¶¶ 3 and 8 (24 TTABVUE 2 and 4).

32. My survey measured whether the name MONSTER ENERGY is famous. In my survey, 87.7% of respondents answered that they had seen or heard of MONSTER ENERGY before today used by a company as the name for a beverage. After taking into account the control, the net measure is 86.2%. In my experience, the survey indicates that the name MONSTER ENERGY is famous among the general consuming public of the United States.<sup>62</sup>

Applicant, in its brief, does not challenge Dr. Isaacson's survey methodology or conclusion, nor did Applicant provide evidence contradicting Dr. Isaacson's declaration and report.

We find that Opposer's marks are inherently or conceptually strong, as well as commercially very strong, if not famous, in connection with beverages, and, therefore, entitled to a broad scope of protection in connection with these goods.

Applicant, in its brief, argues that Opposer's marks are not famous "for *all* purposes and in *all* categories."<sup>63</sup>

Instead, the question is whether the mark (or in this case, marks) are famous with regard to *particular* products in *particular* fields of distribution. ... Nevertheless, Opposer vaguely argues that Opposer's Marks are "famous" and, therefore, entitled to a broad scope of protection.<sup>64</sup>

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To the extent that Opposer's Marks are considered "famous" for energy drinks, fame alone is not sufficient to prove likelihood of confusion.<sup>65</sup>

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<sup>62</sup> *Id.* at ¶¶ 30-32 (24 TTABVUE 8-9).

<sup>63</sup> Applicant's Brief, p. 22 (44 TTABVUE 23).

<sup>64</sup> *Id.*

<sup>65</sup> *Id.* at p. 24 (44 TTABVUE 25).

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Here, Opposer's strongest argument for "fame" is in the specific field of energy drinks, which it acknowledges has generated the majority of its revenue since its inception as a brand. *See* TTABVUE 42 at p. 36. Even the online survey conducted by Opposer only measures the "fame" of "MONSTER ENERGY" as a **beverage**.<sup>66</sup>

In other words, because fame in one category of goods does not necessarily extend to other categories, that Opposer's marks are famous for beverages does not mean that Opposer's MONSTER and MONSTER ENERGY marks are known for e-liquids. *See, e.g., Monster Energy*, 2023 USPQ2d 87, at \*29 ("[T]he fame of the MONSTER ENERGY energy drinks does not extend to restaurant services generally or to restaurants with take-out for flavored and fruit ice products."); *Inter IKEA Sys. B.V. v. AKEA, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014) (opposer's IKEA mark was famous for purposes of likelihood of confusion for its "retail store services in the field of furniture, housewares, and home furnishings," but not for other goods or restaurant services); *Ritz Hotel Ltd. v. Ritz Closet Seat Corp.*, 17 USPQ2d 1466, 1470 n.8 (TTAB 1990) (the fame attributable to opposer's hotel services would not necessarily carry over to personal luxury goods); *Jockey Int'l, Inc. v. Butler*, 3 USPQ2d 1607, 1612 (TTAB 1997) ("[A] marks fame may not extend to all products."); *Fruit of the Loom, Inc. v. Fruit of the Earth, Inc.*, 3 USPQ2d 1531, 1533-34 (TTAB 1987) (finding merit in applicant's argument that while opposer's FRUIT OF THE LOOM mark is best known for underwear, that fame does not extend beyond those products);

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<sup>66</sup> *Id.*

*see also Am. Can Co. v. Dixie Wax Paper Co.*, 407 F.2d 420, 160 USPQ 721, 726 (1969) (fact that DIXIE was famous for paper cups did not support cancellation of and opposition to registration of DIXIE as part of a composite mark for waxed paper; “[S]ince [DIXIE] is part of the language its distinctiveness as a mark has certain definite limitations with respect to products.”).

In this regard, it is common knowledge that owners of famous marks frequently use those marks on collateral or merchandising products such as clothing, mugs and other consumer goods.

We agree with the board that appellee’s evidence establishes that appellee has built up an enormous goodwill in the mark MONOPOLY, which has been used since 1935 for a board game and that MONOPOLY may properly be termed a “famous” mark. We also find no error in the board’s conclusion that it is a matter of common knowledge that famous marks are frequently used on items such as clothing, glassware, and trash cans and that appellee’s licensing of its mark for use on certain novelty items supports this conclusion.

*Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 200 USPQ 986, 988 (CCPA 1981).

Likewise, as the Board found in *Harley-Davidson Motor Co. v. Pierce Foods Corp.*, 231 USPQ 857, 863 (TTAB 1986):

That the mark HARLEY-HOG used on pork products is likely to be associated as to source with opposer is also corroborated by the fact that opposer’s uses of HARLEY and HOG in relation to its collateral goods frequently have been whimsical in character (e.g., HOG piggy banks, T-shirts bearing the phrase, “I LOVE MY HOG HARLEY,” “the HOG Tales” publication, etc.). Because of these uses, a person having knowledge of them would not be surprised to see HARLEY-HOG used in connection with hot dogs or

similar products, and the association with opposer of the mark so used would also be not at all surprising.

However, while it is common knowledge that owners of famous marks frequently use those marks on collateral or merchandising products, this concept or understanding of a famous mark owner's business practices can only be taken so far. While Opposer has proved that its marks are commercially strong, if not famous, for beverages with commercial renown that has spread to collateral merchandise, the strength of Opposer's marks alone is not sufficient to establish likelihood of confusion. If that were the case, having a famous mark would entitle the owner to a right in gross, and that is against the principles of trademark law. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 507 (Fed. Cir. 1983):

The fame of the [plaintiff's] name is insufficient in itself to establish likelihood of confusion under 2(d). "Likely \* \* \* to cause confusion" means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law and to concepts embodied in 15 U.S.C. 1052(d).

See also *Recot*, 54 USPPQ2d at 1898 ("[F]ame alone cannot overwhelm the other *du Pont* factors as a matter of law.").

Nevertheless, "[f]amous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a

weaker mark.” *Recot*, 54 USPQ2d at 1897 (citing *Kenner Parker*, 22 USPQ2d at 1455-56). For this reason, the Federal Circuit emphasizes:

When an opposer’s trademark is a strong, famous mark, it can never be “of little consequence.”

The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

*Recot*, 54 USPQ2d at 1897 (quoting *Specialty Brands, Inc. v. Coffee Bean Distrib., Inc.*, 748 F.2d 669, 223 USPQ 1281, 1284 (Fed.Cir.1984)).

In other words, the fame of an opposer’s mark must be considered when we analyze the similarity or dissimilarity and nature of the goods.

This reasoning applies with equal force when evaluating the likelihood of confusion between marks that are used with goods that are not closely related, because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products. Indeed, it is precisely these circumstances which demand great vigilance on the part of a competitor who is approaching a famous mark, for, as the present case illustrates, the lure of undercutting or discounting the fame of a mark is especially seductive. *See Recot*, slip op. at 19 (“It is applicant’s position that opposer’s marks are famous for a variety of human food products, but that the fame of opposer’s marks does not extend beyond that field...”). Accordingly, we hold that the fame of the mark must always be accorded full weight when determining the likelihood of confusion. When a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a “long shadow which competitors must avoid.” *Kenner Parker*, 963 F.2d at 353, 22 USPQ2d at 1457; *see also Nina Ricci S.A.R.L. v. E.T.F. Enters.*, 889 F.2d 1070, 1074 12 USPQ2d 1901, 1904 (Fed.Cir.1989) (“There is no excuse for even approaching the well-known trademark of a competitor” (internal quotations omitted)). Although fame alone cannot overwhelm the other *DuPont* factors as a

matter of law, *see University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed.Cir.1983), fame deserves its full measure of weight in assessing likelihood of confusion.

*Recot*, 54 USPQ2d at 1898.

With this principle in mind, we analyze the other *DuPont* factors to determine whether there is a likelihood of confusion.

### **B. The similarity or dissimilarity of the marks**

We now turn to the *DuPont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *DuPont*, 177 USPQ at 567. “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019); *accord Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) (“It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion.”) (citation omitted).

In comparing the marks, we are mindful that “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)).

The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 169 USPQ 39, 40 (CCPA 1971); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014); *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012). Inasmuch as the goods at issue include energy drinks and e-liquids for vaping, the average customer is an ordinary consumer.

We keep in mind that “[s]imilarity is not a binary factor but is a matter of degree.” *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *Coors Brewing Co.*, 68 USPQ2d at 1062).

Applicant is seeking to register the mark ICE MONSTER and design reproduced below:



As recounted at the beginning of the decision, Opposer claims ownership of 18 registered marks incorporating the term “Monster Energy” and nine registered marks consisting of the word “Monster” without the word “Energy” for, inter alia, nutritional supplements in liquid form, energy drinks, and collateral merchandise. For example, Opposer uses and has registered MONSTER ENERGY, JUICE MONSTER, PUNCH MONSTER, JAVA MONSTER, and MUSCLE MONSTER.

The word “Monster” is the dominant part of Opposer’s and Applicant’s marks. While the marks must be considered in their entireties, “in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (quoting *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985)).

With respect to Opposer’s MONSTER ENERGY marks, the word “Monster” is the first part of the mark and consumers typically notice those words first. *Monster Energy*, 2023 USPQ2d 87, at \*21 (“Considering the mark MONSTER ENERGY as a whole, we find that the hyperbolic quality of the term MONSTER makes it the dominant term in the mark,” in part because it is the first word and makes the strongest impression); *see also Detroit Athletic Co.*, 128 USPQ2d at 1049 (citations omitted); *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

In addition, Opposer has disclaimed the exclusive right to use the descriptive word “Energy.” “[M]erely descriptive or generic words are accorded less weight in the

likelihood of confusion analysis.” *In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009). *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *Nat’l Data Corp.*, 224 USPQ at 752). Thus, consumers are likely to perceive the distinctive word “Monster” as the source-indicating feature of MONSTER ENERGY rather than the descriptive word “Energy.” *See Tao Licensing*, 125 USPQ2d at 1059 (“[C]onsumers would be more likely to perceive a distinctive term, even if suggestive, rather than a generic term such as VODKA, as the source-indicating feature of the mark.”).

With respect to Opposer’s JUICE MONSTER, PUNCH MONSTER, JAVA MONSTER, and MUSCLE MONSTER, the word “Monster” is again the dominant part of the marks. The prefix words “Juice,” “Punch,” “Java,” and “Muscle” are descriptive imparting information regarding the kind beverage or flavor of MONSTER beverage Opposer is selling. While at first blush, this may seem contrary to what we stated above about the significance of the first word in a mark, there is no mechanical test to select the dominant element of a mark. *Tao Licensing*, 125 USPQ2d at 1059. While the first term in a mark generally is considered to be the feature which will be called for, and so remembered, by consumers, this is not invariably the case. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (“the Board did not err in finding that ‘STONE LION CAPITAL’ is ‘similar in sight, sound, meaning, and

overall commercial impression’ to ‘LION CAPITAL’ and ‘LION.’”); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“Viewed in their entirety with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at \*37 (TTAB 2021) (finding that the word MIRAGE was the more significant portion of the respondent’s ROYAL MIRAGE word mark).

Likewise, the word “Monster” is the dominant part of Applicant’s mark ICE MONSTER and design because the word “Ice” informs the viewer as to the type of monster. Sean Sleiman testified that Applicant selected ICE MONSTER to engender the commercial impression of “the cool taste of our new e-Liquid and associate the e-Liquid with Applicant’s previously successful brands.”<sup>67</sup>

Q. How did you select the Ice Monster mark?

A. The Ice Monster mark was selected after we had already come out with a previous brand, which was Jam Monster. It followed the trend or company strategy we were going in that our Jam Monster brand became a big enough name within the industry that we would now segment different flavor types or categories by different preceding names of monster, Ice Monster, Fruit Monster, Tobacco Monster, Custard Monster.

Q. Okay. What was the intended commercial impression for the Ice Monster mark?

A. A follow-up to Jam Monster, a follow-up brand to Jam Monster. A commercial impression like it’s a

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<sup>67</sup> Sleiman Testimony Decl. ¶ 53 (38 TTABVUE 11).

fruit and menthol, ice. It's a fruit and menthol brand.

Q. I guess what is that supposed to convey to consumers, when they see your Ice Monster mark? Is there something you're trying to convey, a certain message or - -

A. That - - that it's a cool - -

Q. - - feeling?

A. Yeah, a cold, a menthol, a chilly sensation.<sup>68</sup>

The word "Ice" in Applicant's mark ICE MONSTER and design as applied to e-Liquids for vaping suggests a menthol-cool or icy flavor. The word "Ice," therefore, is a descriptive adjective modifying "Monster." *See Monster Energy*, 2023 USPQ2d 87, at \*33 ("Applicant's mark [ICE MONSTER and design] as applied to restaurant services suggests a monster of ice or an icy monster."); *see also Stone Lion Cap. Partners*, 110 USPQ2d at 1161 ("Nor did the Board err by according little weight to the adjective 'STONE,' on the ground that it did not distinguish the marks in the context of the parties' services.") (citing 3 J. Thomas McCarthy, MCCARTHY ON

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<sup>68</sup> Sleiman Discovery Dep., pp. 72-70-(21 TTABVUE 79-80) (improperly designated confidential).

The MERRIAM-WEBSTER DICTIONARY (merriam-webster.com) (accessed August 17, 2023) defines "menthol" as "a crystalline alcohol C<sub>10</sub>H<sub>20</sub>O that occurs especially in mint oils has the odor and **cooling properties** of peppermint." (Emphasis added). *See also* THE RANDOM HOUSE UNABRIDGED DICTIONARY (2023) posted on Dictionary.com (accessed August 17, 2023) ("a colorless, crystalline, slightly water-soluble alcohol, C<sub>10</sub>H<sub>20</sub>O, obtained from peppermint oil or synthesized: used chiefly in perfumes, confections, cigarettes, and liqueurs and in medicine for colds and nasal disorders for its **cooling effect** on mucous membranes."). (Emphasis added).

TRADEMARKS AND UNFAIR COMPETITION § 23:50 (4th ed.) (“[A]ddition of a suggestive or descriptive element is generally not sufficient to avoid confusion.”)).

Applicant’s design element is not so distinctive as to form a commercial impression separate and apart from the term “Ice Monster.” “In the case of marks, such as Applicant’s, consisting of words and a design, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the goods.” *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *Viterra*, 101 USPQ2d at 1908; *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). That is because “[t]he word portion of a word and design mark ‘likely will appear alone when used in text and will be spoken when requested by consumers.’” *Aquitane Wine USA*, 126 USPQ2d at 1184 (quoting *Viterra*, 101 USPQ2d at 1911).

Given the shared word “Monster” in the parties’ marks, consumers familiar with Opposer’s JUICE MONSTER, PUNCH MONSTER, JAVA MONSTER, and MUSCLE MONSTER marks, may perceive Applicant’s ICE MONSTER mark as a variant mark denoting a product line extension. *See SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (“Because of the alliteration with SQUIRT, SQUAD is an apt choice to combine with SQUIRT to suggest a line or group of toys from the same source as SQUIRT balloons. Thus, the marks do not create different commercial impressions.”); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN “more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely,

medical ultrasound devices”); *Schieffelin & Co. v. Molson Cos., Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“Those consumers who do recognize the differences in the marks may believe that applicant’s mark is a variation of opposer’s mark that opposer has adopted for use on a different product.”);

Because Opposer’s MONSTER ENERGY and JUICE MONSTER, PUNCH MONSTER, JAVA MONSTER, and MUSCLE MONSTER are registered in typed drawing or standard characters,<sup>69</sup> we must assume that they “could be used in any typeface, color, or size, including the same stylization actually used or intended to be used by [Applicant], or one that minimizes the differences or emphasizes the similarities between the marks.” *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816,1823 (TTAB 2015). *See also Viterra*, 101 USPQ2d at 1909-11; *Citigroup Inc*, 98 USPQ2d at 1259; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) (rejecting argument that for purposes of determining whether two marks are similar, a mark in a typed drawing (equivalent to modern standard character format) is distinct from such mark in a logo format; “[b]y presenting its mark in a typed drawing, a difference cannot legally be asserted by that party” (emphasis in original)). Accordingly, we must assume that the words MONSTER ENERGY and JUICE MONSTER, PUNCH MONSTER, JAVA MONSTER, and MUSCLE MONSTER could be displayed in the distinctive font,

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<sup>69</sup> As noted above, a typed mark is the legal equivalent of a standard character mark. *See Viterra*, 101 USPQ2d at 1909 n.2 (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks.”).

relative sizes, colors, and, where appropriate, in a stacked presentation in which the words ICE MONSTER appear in Applicant's mark.

We also keep in mind the penchant for consumers to shorten names. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983) ("Although the record does not indicate that applicant's business is commonly referred to as "Giant", it does indicate that people have called it by that name, omitting the word "Hamburgers". Thus, in a conversation between two consumers in opposer's area about a place of business called "Giant", there likely would be confusion about which "Giant" they were talking about."); *In re Bay State Brewing*, 117 USPQ2d 1958, 1961 (TTAB 2016) (holding it is reasonable for consumers to drop the highly descriptive term "Blonde" when calling the TIME TRAVELER BLONDE beer); *Big M Inc. v. The United States Shoe Co.*, 228 USPQ 614, 616 (TTAB 1985) ("[W]e cannot ignore the propensity of consumers to often shorten trademarks and, in the present case, this would be accomplished by dropping the 'T.H.' in referring to registrant's stores [T.H. MANDY]."). Likewise, it is reasonable to assume that at least some customers will refer to both Opposer's products and Applicant's products as MONSTER.

While there are both similarities and differences between the parties' marks in appearance, sound, and connotation and commercial impression, we find that the differences in the marks fails to distinguish them inasmuch as they share the distinctive, non-descriptive word "Monster." "[I]f the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences." *In*

*re Denisi*, 225 USPQ 624, 624 (TTAB 1985). Therefore, we find that Applicant's mark ICE MONSTER and Opposer's MONSTER ENERGY and JUICE MONSTER, PUNCH MONSTER, JAVA MONSTER, and MUSCLE MONSTER marks are similar in sound, appearance, connotation and commercial impression. *See Monster Energy*, 2023 USPQ2d 87, at \*36-37 (finding applicant's ICE MONSTER and design similar to opposer's MONSTER ENERGY marks).

This factor weighs in favor of a finding that confusion is likely.

**C. Opposer uses its MONSTER marks on a wide variety of goods**

"The ninth *DuPont* factor takes into account the variety of goods on which a mark is or is not used." *DeVivo*, 2020 USPQ2d 10153, at \*15 (citing *DuPont*, 177 USPQ2d at 567); *see also Monster Energy*, 2023 USPQ2d 87, at \*39; *In re Hitachi High-Technologies Corp.*, 109 USPQ2d 1769, 1774 (TTAB 2014) ("[C]onsumers who may be familiar with various products in the [Opposer's] product line, when confronted with applicant's mark, would be likely to view the goods marked therewith as additional products from [Opposer]."). "If a party in the position of plaintiff uses its mark on a wide variety of goods, then purchasers are more likely to view a defendant's related good under a similar mark as an extension of the plaintiff's line." *DeVivo*, 2020 USPQ2d 10153, at \*15.

Opposer argues that because it uses its MONSTER and MONSTER ENERGY marks on a wide variety of goods, it is more likely consumers will be confused by

Applicant's ICE MONSTER mark for e-liquids.<sup>70</sup> Indeed, the record shows that Opposer's MONSTER and MONSTER ENERGY marks for energy drinks have been used on a wide variety of goods beyond its core beverage products in an extensive collateral licensing program.<sup>71</sup> Thus, this enhances the likelihood of confusion of a similar mark in connection with e-Liquids.

We keep this finding in mind when we analyze the similarity or dissimilarity of the goods. In other words, Opposer's use of its MONSTER ENERGY and MONSTER marks on a wide variety of products is a fact we take into consideration in analyzing whether consumers perceive Applicant's ICE MONSTER e-liquids as emanating from the same source as Opposer's MONSTER ENERGY and MONSTER products.

**D. The similarity or dissimilarity and nature of the goods**

Applicant is seeking to register ICE MONSTER and design for "electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges." Specifically, "E-liquid in 100-mil and 30-mil e-liquid bottles, one being a free-based nicotine liquid, the other being a salt-based nicotine liquid."<sup>72</sup>

17. ... Applicant sells bottles of replacement e-Liquid that customers use to refill the e-Liquid cartridges of their

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<sup>70</sup> Opposer's Brief, p. 43 (42 TTABVUE 51).

<sup>71</sup> Sacks' Testimony Decl. ¶¶ 17-19 and 23-24 (25 TTABVUE 8-12).

<sup>72</sup> Sleiman Discovery Dep., p. 27 (21 TTABVUE 34).

We refer to Sleiman's discovery deposition and his testimony declaration below to shed light on the meaning of Applicant's description of goods. *See In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990) ("[W]hen the description of goods for a cited registration is somewhat unclear, as is the case herein, it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic

personal vape devices. Applicant does not sell vape devices or components of vape devices.

18. For each flavor of e-Liquid that Applicant offers for sale, Applicant offers multiple SKUs of that same flavor with varying amounts of nicotine, which allows the customer to choose the amount of nicotine, which may help the customer break his or her smoking habit.<sup>73</sup>

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A person who vapes would fill their 5-millimeter tank up, essentially, which is the normal tank size now in the market, they would fill their 5-millimeter tank with the 100-mil bottle. The tank would last them about half-a-day to a day, again, depending how often they vape, every ten second, or every ten minutes.<sup>74</sup>

Applicant sells only a fruit and menthol blend of e-liquids (i.e., Ice Monster Mangerine Guava, Ice Monster Strawmelon Apple, Ice Monster Melon Colada, Ice Monster Salt Strawmelon Apple, and Ice Monster Salt Mangerine Guava) which include menthol.<sup>75</sup>

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evidence showing that the description of goods has a specific meaning to members of the trade.” (internal citations omitted). *See also In re W.W. Henry Co.*, 82 USPQ2d 1213, 1215 (TTAB 2007). We have considered Applicant’s evidence in that light and not as an improper attempt to restrict its goods as identified in the application.

<sup>73</sup> Sleiman Testimony Decl. ¶¶ 17 and 18 (38 TTABVUE 6).

The RANDOM HOUSE UNABRIDGED DICTIONARY (2023) posted on Dictionary.com (accessed August 8, 2023) defines SKU as a “stockkeeping unit: a retailer-defined coding system used to distinguish individual items within a retailer’s accounting, warehousing, and point-of-sale systems.” The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format or have regular fixed editions. *In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014), *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016); *In re Omniome, Inc.*, 2020 USPQ2d 3222, at \*2 n.17 (TTAB 2019).

<sup>74</sup> Sleiman Discovery Dep., pp. 27-28 (21 TTABVUE 34-35).

<sup>75</sup> Sleiman Testimony Decl. ¶ 48 (38 TTABVUE 10).

Opposer uses and has registered its MONSTER and MONSTER ENERGY marks for a wide variety of products, including but not limited to energy drinks, nutritional supplements in liquid form, and a wide array of merchandising products such as clothing, stickers, bags, helmets, hats, etc.

Regarding whether the parties' products are related, Applicant's co-founder/co-owner Sean Sleiman testified as follows:

- Applicant's product "is an alternative for someone to quit smoking cigarettes."<sup>76</sup>
- "Applicant never has manufactured or sold any beverage product."<sup>77</sup>
- "Applicant's e-Liquid products always are displayed at room temperature and never are displayed in commercial coolers. [Sleiman has] never seen Applicant's e-Liquid products displayed for sale immediately adjacent to any beverage, including energy drinks."<sup>78</sup>
- Sleiman has "never heard or seen an energy-drink flavored e-Liquid in the United States."<sup>79</sup>
- "Applicant has never received an inquiry about energy-drink flavored e-Liquids."<sup>80</sup>
- Sleiman has "never seen any person vaping energy drinks, likely because doing

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<sup>76</sup> Sleiman Discovery Dep., p. 106 (21 TTABVUE 113).

<sup>77</sup> Sleiman Testimony Decl. ¶ 19 (38 TTABVUE 6).

<sup>78</sup> *Id.* at ¶ 28 (38 TTABVUE 8).

<sup>79</sup> *Id.* at ¶ 43 (38 TTABVUE 10).

<sup>80</sup> *Id.* at ¶ 44 (38 TTABVUE 10); Sleiman Discovery Dep., p. 131 (21 TTABVUE 138).

so would not be possible.”<sup>81</sup>

- Sleiman has “never seen or heard of a publication, article, or other report that describes a correlation between vaping and energy drink consumption,”<sup>82</sup> nor has he heard of “smokers pairing vaping or cigars with energy drinks.”<sup>83</sup>

- Sleiman is unaware “of any customer feedback that has mentioned an energy drink, a beverage sold by Opposer, or a request for Applicant to sell an energy-drink-flavored e-Liquid.”<sup>84</sup>

- To Sleiman’s knowledge, “no beverage or energy drink company, including Opposer, sells or licenses any type of tobacco or nicotine product, including vape devices of e-Liquids.”<sup>85</sup>

To prove the goods are related, Opposer introduced the testimony declaration of Rodney Sacks, Chairman and Co-Chief Executive Officer of Monster Beverage Corporation, a subsidiary of Opposer, who testified as follows:

- Sacks testified that he is aware that “consumers often use smoking-related products in conjunction with MONSTER-brand beverages.”<sup>86</sup> To support his

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<sup>81</sup> *Id.* at ¶ 46 (38 TTABVUE 10); Sleiman Discovery Dep., p. 131 (21 TTABVUE 138).

<sup>82</sup> *Id.* at ¶ 47 (38 TTABVUE 10); Sleiman Discovery Dep., p. 106 (21 TTABVUE 113). Nevertheless, when asked whether he was aware of any correlation between smoking and energy drink consumption, Sleiman said, “I assume people that smoke also like to drink, right?” *Id.*

<sup>83</sup> Sleiman Discovery Dep., pp. 131-132 (21 TTABVUE 138-139).

<sup>84</sup> Sleiman Testimony Decl. ¶ 58 (38 TTABVUE 12); Sleiman Discovery Dep., pp. 119 and 132 (21 TTABVUE 126 and 139).

<sup>85</sup> *Id.* at ¶ 61 (38 TTABVUE 12).

<sup>86</sup> Sacks Testimony Decl. ¶ 30 (25 TTABVUE 14).

testimony, Sacks introduced images, reproduced below, posted by one or two unidentified consumers “pairing MONSTER-brand beverages with electronic cigarettes.”<sup>87</sup>



Opposer also introduced excerpts from the Reddit website (reddit.com) purportedly to show “the similarity or relatedness of Opposer’s and Applicant’s goods.”<sup>88</sup> For example,<sup>89</sup>

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<sup>87</sup> *Id.* (25 TTABVUE 14-15). As noted above, Applicant’s products are not electronic cigarettes. There are no images of MONSTER beverages with E-liquid in 100-mil or 30-mil bottles. Applicant’s products are one step removed from electronic cigarettes. In addition, as noted above Sean Sleiman, Applicant’s co-owner, is unaware of any “smokers pairing vaping or cigars with energy drinks.” <sup>87</sup> Sleiman Discovery Dep., pp. 131-132 (21 TTABVUE 138-139).

<sup>88</sup> 18 TTABVUE 5-7.

<sup>89</sup> We did not find the post at 18 TTABVUE 123 probative. The person starting the thread inquired about a “citrusy flavor[ed]” ejuice like one might find in an energy drink. That person was not referring to an association, sponsorship or affiliation of some kind between energy drinks and e-liquids for vaping. None of the responses referred to an association, sponsorship or affiliation of some kind between energy drinks and e-liquids for vaping.

We did not find the post at 19 TTABVUE 3 – “A Quick Slim’s Ejuice Review - Blue Razz, Elderberry, Black Demon” – probative. The author merely referred to “Blue Demon Energy as “It’s original Monster Energy” referring to the flavor tasting like a MONSTER beverage

- At <[reddit.com/r/Vaping/comments/](https://www.reddit.com/r/Vaping/comments/)> “Reddit’s Premier Global Vaping Community” with a purported 131,000 members, a Reddit user posted a thread entitled “Anyone know if there’s a vape juice for Monster The Doctor or something close?” (created January 17, 2010).<sup>90</sup> There were six responses.

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as opposed to an association, sponsorship, or affiliation between the source of energy drinks and e-liquids.

We did not find the post at 19 TTABVUE 9 – “Uncle Junk’s: Monica Eyes (Review)” – probative. The author merely likened the taste an e-liquid to “DeKang’s RedCow (Redbull knockoff) and [Opposer’s] Rockstar ejuice” inasmuch as “[t]hey had a ‘carbonated energy drink’ taste in common that’s hard to describe.” The post does not imply or infer that energy drinks and e-liquids emanate from the same source or are otherwise sponsored by, affiliated with, or have an association.

For the same reason, we did not find the post at 19 TTABVUE 15 – “E-liquid recommendations?” – probative. The author wrote that he is looking for “a quality red bull/monster-type flavor profile.” The author did not imply there is an association, sponsorship or affiliation between energy drinks and e-liquids.

We did not find the post at 19 TTABVUE 23 – “Such eJuice. Many vapes!” – probative. The author refers to “Red Bull” as a flavor in the same way he/she refers to “BACON,” “Pomegrante,” “White Chocolate,” etc.

We did not find the post at 19 TTABVUE 45 and 52 – “Good flavors to vape while drinking coffee?” – because the topic of the thread is what vape flavors pair well with coffee. One possible posting, (19 TTABVUE 45) a response, refers to the flavor “blueberry jam monster and it’s amazing.” There is nothing in the record indicating that “blueberry jam monster” is one of Opposer’s flavors. Another response (19 TTABVUE 52) refers to energy drinks, not e-liquids.

<sup>90</sup> 18 TTABVUE 78 and 88. The thread is closed.

The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face and may not be used to demonstrate the truth of what has been printed because they constitute hearsay. *See, e.g., Empresa Cubana Del Tabaco d.b.a. Cubatabaco v. General Cigar Co.*, 2022 USPQ2d 1242, at \*7 (TTAB 2022) (where “the parties seek to rely on the contents of the webpages for the truth of any assertion made therein, the statements in the websites are hearsay unless supported by testimony or other evidence.”), *civil action filed*, No. 1:23-cv-00227 (E.D. Va. Feb. 20, 2023); *Chutter, Inc. v. Great Mgmt. Group, LLC*, 2021 USPQ2d 1001, at \*33 n.69 (TTAB 2021) (YouTube video stating number of “results” and “views” admissible only to show what has been printed, not the truth of what has been printed), *appeal docketed*, No. 22-1212 (Fed. Cir. 2021); *Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at \*2 (TTAB 2020) (Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony

- At <reddit.com/r/electronic\_cigarette>, “a subreddit for discussing everything e-cigs and vaping, with a purported 201,000 members, a Reddit user posted a thread entitled “Energy Drink Flavored EJuice?” (created September 17, 2008) with seven responses.<sup>91</sup>

- At <reddit.com/r/electronic\_cigarette>, a Reddit user posted a thread entitled “Best flavor ejuice to mimic an energy drink” (created September 17, 2008) with 11 responses.<sup>92</sup>

- At <reddit.com/r/electronic\_cigarette>, a Reddit user posted a thread entitled “Anyone know of a NOS Energy ejuice?” (created September 17, 2008) with six responses.<sup>93</sup>

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considered only for what they show on their face rather than for the truth of the matters asserted).

<sup>91</sup> 18 TTABVUE 97 and 104. The thread is closed. We understand that, when a thread is “closed,” this means the originator of the thread is not accepting new comments. If a discussion thread is “closed,” the posts therefore could be outdated, so their probative value is further limited.

“A message thread groups messages into a conversation by topic instead of purely chronologically. For example, a user on a web forum can create a post, and all replies to that post are part of its thread.” TechTerms.com (“The Computer Dictionary”) (accessed August 18, 2023); *see also* Computer Dictionary of Information Technology (computer-dictionary-online.org) (accessed August 18, 2023 (“A more or less continuous chain of postings on a single subject, sent to a forum such as Usenet newsgroup. To ‘follow a thread’ is to read a series of postings sharing a common subject.”)).

<sup>92</sup> 18 TTABVUE 110-111 and 117. The threads are closed.

<sup>93</sup> 18 TTABVUE 128. The thread is closed.

- At <reddit.com/r/electronic\_cigarette>, a Reddit users posted “Best Red Bull ejuice” (created September 17, 2008) inquiring about an e-liquid with “red bull flavor” with 12 responses.<sup>94</sup>

In addition, Opposer also introduced an excerpt from a Twitter posting where one user posted “Is anyone else kind of surprised that Monster Energy Drinks hasn’t made a line of Vape products?” (October 21, 2018).<sup>95</sup>

In sum, Opposer introduced six relevant closed threads posted on the Reddit social media website in 2008 and 2010, as well as a 2018 Twitter posting, inquiring whether there are any energy drink flavored e-liquids. The posts garnered a handful of responses. This supposed outpouring of interest in energy drink flavored e-liquids is unimpressive. For example, Opposer was unable to introduce any evidence of third-party use or registration of any company using the same mark to identify energy drinks or other beverages and e-liquids. Moreover, there is no evidence of any third party manufacturing both energy drinks and e-liquids with different marks. Finally, as noted above, Sean Sleiman has “never heard or seen an energy-drink flavored e-Liquid in the United States,”<sup>96</sup> nor has Applicant received an inquiry about energy-drink flavored e-Liquids.”<sup>97</sup>

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<sup>94</sup> 19 TTABVUE 58. The thread is closed.

<sup>95</sup> 19 TTABVUE 64.

<sup>96</sup> Sleiman Testimony Decl. ¶ 43 (38 TTABVUE 10).

<sup>97</sup> *Id.* at ¶ 44 (38 TTABVUE 10); Sleiman Discovery Dep., p. 131 (21 TTABVUE 138).

Opposer introduced the following studies showing a correlation between consuming energy drinks and smoking:

- “Coffee and cigarettes: Examining the association between caffeinated beverage consumption and smoking behavior among youth in the COMPASS study,” Preventive Medicine Reports (elsevier.com/locate/pmedr) (June 18, 2020), a Canadian study finding “coffee, sugar-sweetened beverage (SSB) and high energy consumption have been related to increases in risky behavior, including smoking.”<sup>98</sup>

- “Relations Among Caffeine Consumption, Smoking, Smoking Urge, and Subjective Smoking Reinforcement in Daily Life,” Journal of Caffeine Research (researchgate.net) (September 2014) reporting that “[c]affeine consumption and cigarette smoking tend to occur within the same individuals and at the same time” in part because “caffeine consumption increases subjective smoking reinforcement.”<sup>99</sup>

In other words, drinking caffeinated drinks, including energy drinks, stimulates the urge to smoke just like, for example, waking up in the morning stimulates the urge to smoke, finishing a meal stimulates the urge to smoke, or drinking alcohol at a bar stimulates the urge to smoke. In addition, people also like to smoke in a social setting. All that these studies confirm is that smoking is a pernicious habit which is easily triggered rather than showing that consumers would perceive an association,

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<sup>98</sup> 19 TTABVUE 92.

<sup>99</sup> 19 TTABVUE 101. The study does not display the url and date but Opposer provided that information at 18 TTABVUE 10.

sponsorship, or some sort of affiliation between the source of energy drinks and e-liquids were they to be advertised or sold under the same or similar marks.

Finally, Opposer contends that consumers perceive an association between energy drinks and e-liquids for vaping because “Applicant describes its e-liquid product the way one would describe a beverage.”<sup>100</sup> For example:

Melon Colada is a satisfying fusion of tropical fruits, crisp melons and refreshing menthol. As you take puffs of Melon Colada, you’ll feel like you’re on a tropical beach as pineapple, coconut, melon and mint flavors take turns exciting your taste buds. If you crave mint-infused fruity flavors, this is the ultimate treat for your palate.<sup>101</sup>

Applicant describes its products the same way anyone would describe a fruit flavored product. We note that Applicant does not describe its products the way Opposer describes its energy drinks (i.e., by promoting the buzz). For example:

#### MONSTER ENERGY

Tear into a can of the meanest energy drink on the planet.  
Monster Energy.

It’s the ideal combo of the right ingredients in the right proportion to deliver the big bad buzz that only Monster can. Monster packs a powerful punch but has a smooth easy drinking flavor.

Athletes, musicians, anarchists, co-ed’s, road warriors, metal heads, geeks, hipsters, and bikers dig it-you will too.

*Unleash The Beast.*<sup>102</sup>

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<sup>100</sup> Opposer’s Brief, p. 42 (42 TTABVUE 50).

<sup>101</sup> Applicant’s website (monstervapelabs.com) (20 TTABVUE 48-51).

<sup>102</sup> Sacks Testimony Exhibit 29 (27 TTABVUE 18).

PUNCH MONSTER

PUNCH ENERGY

Punch Monster is a new take on a classic. It's sweet like the punch you mixed yourself as a kid, but with a little carbonation for a smooth finish.

Don't let the familiar taste fool you. Baller's Blend is high performance fuel that's optimized for the true baller. Packed with a full load of or Monster energy blend, Baller's Blend will keep you going strong through the last round.

*Unleash The Beast.*<sup>103</sup>

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JUICE MONSTER

ENERGY + JUICE

Our Pro Athletes are always looking for an edge, so when they've got an idea, we listen. After months in the lab we perfected the "Juice Monster."

We started with our original Monster flavor, mixed in a killer combo of fruit juices, then powered it up with the full load of our energy blend and stood back.

It's Alive ...

Khaos, an insane Juice-Monster hybrid bubbling with the great Monster taste and the big bad buzz you know and love.

*Unleash The Beast.*<sup>104</sup>

While we have analyzed Opposer's evidence individually, we must also analyze it in its entirety. That is, we must weigh the evidence as a whole, rather than

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<sup>103</sup> Sacks Testimony Exhibit 29 (27 TTABVUE 12).

<sup>104</sup> *Id.* at 27 TTABVUE 15.

considering each piece of evidence in isolation. *Cf. W. Fl. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (“[W]hether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.”).

Taking into consideration the totality of the evidence, including Opposer’s use of its MONSTER and MONSTER ENERGY marks on a wide variety of products, Sean Sleiman’s testimony and the lack of any third-party use or registrations for the same mark identifying energy drinks or beverages and e-liquids, we do not perceive a relationship between energy drinks, beverages, or nutritional supplements and e-liquids. That a few people have commented about energy drink flavored vapes fails to persuade us that a significant segment of energy drink, beverage or nutritional supplement users perceive a connection, sponsorship or affiliation between the source of those products and e-liquids for vaping. We find that Opposer failed to prove that its energy drinks, beverages, or nutritional supplements are related to e-liquids; that is, consumers will not perceive that these products emanate from the same source or that they are associated or affiliated with a single source because they are advertised or sold under similar marks.

**E. Established, likely-to-continue channels of trade and classes of consumers**

Opposer contends that the parties’ goods are offered in the same channels of trade

for the following reasons:<sup>105</sup>

- The parties' goods are sold on the Internet;<sup>106</sup>
- The parties market and promote their goods on the Internet, including through their social media accounts;<sup>107</sup> and
- The parties' goods are sold in vape shops.<sup>108</sup>

In addition, Opposer asserts that both parties targets the same consumers (i.e., males and females 21 years of age or older).<sup>109</sup>

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<sup>105</sup> Opposer's Brief, pp. 40-41 (42 TTABVUE 48-49).

<sup>106</sup> Applicant's response to Opposer's request for admission No. 18 (14 TTABVUE 223) (Applicant admits that it sells its products online); Sleiman Discovery Dep., p. 76 (21 TTABVUE 83) (improperly designated confidential); Sacks Testimony Decl. ¶ 15 (25 TTABVUE 8) ("[Opposer's] MONSTER line of drinks are also sold online, including on amazon.com, Walmart.com, and monsterarmy.com); Sleiman Testimony Decl. ¶ 31 (38 TTABVUE 8) ("Applicant has never sold any of its products on amazon.com, target.com, or cvs.com); Sacks Testimony Decl. ¶ 109 (25 TTABVUE 41) ("[Opposer] has made extensive use of the Internet and recent advances in social media to promote its brand.").

<sup>107</sup> Sleiman Discovery Dep., p. 76 (21 TTABVUE 83) (Applicant promotes its products on Instagram, its website and distributors websites); *id.* at p. 77 (21 TTABVUE 84) (Applicant does not promote its products on any websites that Opposer uses to promote or sell its products); Sacks Testimony Decl. ¶ 32 ("[Opposer] has widely advertised, marketed, and promoted its products bearing the MONSTER Marks through the sponsorship of athletes and athletic competitions around the world (which includes vast conventional and digital media."); Sacks Testimony Decl. ¶ 109 (25 TTABVUE 41) ("[Opposer] has made extensive use of the Internet and recent advances in social media to promote its brand."); Sacks Testimony Decl. ¶¶ 110-118 (25 TTABVUE 41-44).

<sup>108</sup> Sleiman Testimony Decl. ¶ 24 (38 TTABVUE 7) ("Applicant sells its e-Liquids in vape shops, smoke shops, on vape-specific distributors' websites, and on Applicant's website."); *id.* at ¶ 25 (38 TTABVUE 7) (to the best of Sleiman's knowledge, "there are no energy drinks offered for sale on the websites that sell Applicant's e-Liquids."); *id.* at ¶ 27 (38 TTABVUE 7) ("For those smoke shops that do sell beverages or energy drinks, [Sleiman has] always seen the beverages or energy drinks displayed together in a commercial cooler located in the shop."); Vega Testimony Decl. ¶¶ 4-9 and (23 TTABVUE 2-3 and 7-31).

<sup>109</sup> Opposer's Brief, p. 41 (42 TTABVUE 49); Sleiman Testimony Decl. ¶ 20 (38 TTABVUE 6-7) ("Applicant's target customers are ages 21 and older who want to quit smoking by way of vaping."); Sack's Testimony Decl. ¶ 33 (25 TTABVUE 16) (Opposer's primary target market is young adults aged 18-34, primarily males with an increasing number of female consumers).

That both parties market and sell their products through the Internet is unpersuasive. The Board has long recognized that the “Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet,” *Bond v. Taylor*, 119 USPQ2d 1049, 1055 (TTAB 2016) (quoting *Parfums de Coeur, Ltd. v. Lory Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007)), and that “the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade.” *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1743 (TTAB 2014) (quoting *Parfums de Coeur*, 83 USPQ2d at 1021). This reasoning applies with equal force to social media such as X (fka Twitter) and Facebook, which, like the Internet itself, are today “pervasive med[ia]” that are used to promote all manners of goods and services. The channels of trade for the parties’ goods do not overlap merely because they are offered on the Internet and through pages shown on the same social media platforms.

Robert Vega, the private investigator retained by Opposer to document the sale of energy drinks and e-liquids in vape/smoke shops obtained evidence from six vape/smoke shops.<sup>110</sup> In each instance, the vape/smoke shop displayed Opposer’s MONSTER energy drink in a cooler with other name brand drinks. The three photographs reproduced below are illustrative:

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<sup>110</sup> Vega Testimony Decl. ¶¶ 3-9 and (23 TTABVUE 2-3 and 7-31).



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<sup>111</sup> Vega Testimony Exhibit 1 (23 TTABVUE 8).

<sup>112</sup> Vega Testimony Exhibit 3 (23 TTABVUE 13).



The vape/smoke shops offer Opposer’s MONSTER and MONSTER ENERGY beverages in coolers displaying third-party brand names (e.g., Pepsi, Coca-Cola, and RockStar Energy Drink) indicating that the beverages sold in the vape/smoke shops are merely one of many varied products these companies sell. In this regard, the vape/smoke shops are similar to convenience stores in that they offer a multitude of different products.

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<sup>113</sup> 23 TTABVUE 25.

The fact that many different products are sold in the same stores is not necessarily probative.

A wide variety of products, not only from different manufacturers within an industry but also from diverse industries, have been brought together in the modern supermarket for the convenience of the customer. The mere existence of such an environment should not foreclose further inquiry into the likelihood of confusion arising from the use of similar marks on any goods so displayed.

*Federated Foods*, 192 USPQ at 29. *See also Recot*, 54 USPQ2d at 1899-1900 (absent some evidence that the products are sold in close proximity to one another, the fact that the products at issue are sold in supermarkets does not weigh in favor of finding a likelihood of confusion).

Finally, Opposer contends that the parties offer their wares to the same classes of consumers because they both target adults 21 and older. In other words, everybody. Opposer essentially asserts that because its target market includes all adults, Opposer's class of consumers includes consumers for every product sold in U.S. commerce. This contention is unsupported by the evidence.

In essence, Opposer contends that the parties offer their goods on the Internet, through social media and common retail stores to all adults, the channels of trade and classes of consumers are the same. We disagree and find instead that Opposer actually is seeking a right in gross, something trademark law prohibits. *See Carefirst of Maryland Inc.*, 77 USPQ2d at 1507.

We find on this record that, although the parties channels of trade and classes of consumers overlap on a tangentially macro level, for purposes of our likelihood of

confusion analysis, the channels of trade and classes of consumers are a neutral factor in our consideration of whether confusion is likely.

**F. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.**

Neither Opposer, nor Applicant, is aware of any reported instances of actual confusion.<sup>114</sup> The absence of any reported instances of confusion is meaningful only if the record indicates appreciable and continuous use by the parties of their marks for a significant length of time in the same markets. *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to occur. *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1287 (TTAB 2007) (the probative value of the absence of actual confusion depends upon there being a significant opportunity for actual confusion to have occurred); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406-1407 (TTAB 1988); *Central Soya Co., Inc. v. N. Am. Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) (“[T]he absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.”).

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<sup>114</sup> Sleiman Testimony Decl. ¶¶ 58-60 (38 TTABVUE 12); Sleiman Discovery Dep., pp. 119 and 127 (21 TTTABVUE 126 and 134); Applicant's response to Opposer's Interrogatory No. 28 (14 TTABVUE 211); Applicant's response to Opposer's request for production of documents No. 26 (14 TTABVUE 267) (no documents relating to any instances of confusion); Opposer's response to Applicant's interrogatory No. 6 (37 TTABVUE 44-45).

According to Opposer's witness, Rodney Sacks, Opposer launched its MONSTER ENERGY drinks in April 2002.<sup>115</sup> Applicant, on the other hand, has been using its mark since July 11, 2016.<sup>116</sup> In addition, since the start of 2019, Applicant has distributed its products in all 50 states.<sup>117</sup> That is over five years of simultaneous use without any reported instances of confusion.

Since its launch, Opposer's MONSTER ENERGY and MONSTER drinks have grown into an industry leader.<sup>118</sup>

By 2003, [Opposer's] beverages were being sold in all 50 states in gas stations, convenience stores, grocery stores, gyms, health food stores, independent stores, mass merchandisers such as Costco, Wal-Mart, and Target, and drug stores such as CVS and Walgreens. [Opposer's] MONSTER line of drinks are now sold by over 380,000 retail stores all over the country. [Opposer's] MONSTER line of drinks are also sold by on-premise retailers such as restaurants, coffee shops, sports venues, gyms, bars, and theme parks. [Opposer's] MONSTER line of drinks are also sold online, including on [A]mazon.com, Walmart.com, and monsterarmy.com.<sup>119</sup>

In addition to selling beverages, Opposer uses and licenses its MONSTER and MONSTER ENERGY marks on a wide range of other products, including, but not limited, to clothing, protective gear, helmets, stickers, and jewelry.<sup>120</sup> Since 2002,

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<sup>115</sup> Sacks Testimony Decl. ¶¶ 3 and 7 (25 TTABVUE 3 and 5).

<sup>116</sup> Sleiman Testimony Decl. ¶ 4 (38 TTABVUE 4); Sleiman Discovery Dep., p. 66 (21 TTABVUE 73); Applicant's response to Opposer's interrogatory No. 7 (14 TTABVUE 205).

<sup>117</sup> Sleiman Discovery Dep., p. 125 (21 TTABVUE 132).

<sup>118</sup> Sacks Testimony Decl. ¶¶ 3 and 4 (25 TTABVUE 3).

<sup>119</sup> Sacks Testimony Decl. ¶ 15 (25 TTABVUE 8).

<sup>120</sup> Sacks Testimony Decl. ¶ 17 (25 TTABVUE 8-9).

Opposer has sold or distributed millions of articles of MONSTER or MONSTER ENERGY clothing and other merchandise.<sup>121</sup> “There is a **huge demand** for t-shirts, hats, jackets, sweatshirts, bags, and other clothing, gear, and merchandise bearing the MONSTER Marks.”<sup>122</sup> (Emphasis added).

Currently, Opposer sells approximately 2.5 billion cans of MONSTER ENERGY and MONSTER beverages per year in the United States.<sup>123</sup>

[I]n the U.S. alone, [Opposer’s] gross sales of its Monster line of beverages for the year ending December 31, 2019 increased to US\$2.9 billion from US\$2.85 billion in 2018, from US\$2.55 billion in 2017, from US\$2.39 billion in 2016, from US\$2.2 billion in 2015, from US\$2.01 billion in 2014, from US\$1.85 billion in 2013, from US\$1.72 billion in 2012, and from US\$1.43 billion in 2011. ... **MONSTER is now one of the most recognized brands in the world today.**<sup>124</sup> (Emphasis added).

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<sup>121</sup> Sacks Testimony Decl. ¶ 18 (25 TTABVUE 9).

<sup>122</sup> Sacks Testimony Decl. ¶ 19 (25 TTABVUE 9).

<sup>123</sup> Sacks Testimony Decl. ¶ 29 (25 TTABVUE 9). Foreign use of Opposer’s marks is not relevant to the issues in a Board proceeding. For general rule, see *Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612-13 (TTAB 1991); *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974) (foreign use of mark creates no rights in mark in U.S.). See also *Oland’s Breweries [1971] Ltd. v. Miller Brewing Co.*, 189 USPQ 481, 489 n.2 (TTAB 1975) (use or promotion of a mark confined to a foreign country, including Canada, is immaterial to ownership and registration in U.S.), *aff’d*, *Miller Brewing Co. v. Oland’s Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976). At various times, Rodney Sacks testified as to Opposer’s worldwide sales. Unless Mr. Sacks expressly testified as to Opposer’s U.S. sales or advertising, we will not speculate as the portion of sales or advertising should be apportioned to Opposer’s business in the U.S.

<sup>124</sup> Sacks Testimony Decl. ¶ 29 (25 TTABVUE 13-14).

Likewise, Applicant is “No. 1, if not top three, in the entire US in e-liquid sales” per ECigIntelligence.<sup>125</sup> Applicant’s annual sales figures are set forth below:<sup>126</sup>

2016:	\$624,755
2017:	\$1,087,495
2018:	\$1,828,338.28
2019:	\$1,336,730.32
2020:	\$1,079,143.95

Opposer sponsors athletes, musicians and events to create widespread exposure and awareness of its MONSTER ENERGY and MONSTER marks among Opposer’s primary target market of young adults ages 18 to 34 years old.<sup>127</sup> Similarly, Applicant’s target demographic customers are ages 21 and older who want to quit smoking by vaping.<sup>128</sup> However, because of restrictions on where tobacco products and other smoking products may be advertised,<sup>129</sup> Applicant does not advertise on

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<sup>125</sup> Sleiman Discovery Dep. pp. 90 and 98 (21 TTABVUE 97 and 105).

<sup>126</sup> Applicant’s third amended response to Opposer’s interrogatory No. 14 (14 TTABVUE 243). Sleiman testified that the price of Applicant’s products are between \$23-\$32. On Applicant’s website the products cost \$27. Sleiman Discovery Dep., p. 126 (21 TTABVUE 133); *see also* Sleiman Testimony Decl. ¶ 55 (38 TABVUE 11) (“[T]he retail price range at a smoke shop or vape shop for a single ICE MONSTER e-Liquid bottle ranges from \$22 to \$32.”). If we take \$27 as the average price, then Applicant sold approximately 23,139 units in 2016, 40,277 units in 2017, 67,716 units in 2018, 49,508 units in 2019, and 39,968 units in 2020.

<sup>127</sup> Sacks Testimony Decl. ¶¶ 32-34 (25 TTABVUE 16-17).

<sup>128</sup> Sleiman Testimony Decl. ¶¶ 20 and 23 (38 TTABVUE 6-7); Applicant’s response to Opposer’s interrogatory No. 20 (14 TTABVUE 209).

<sup>129</sup> Sleiman Testimony Decl. ¶ 34 (38 TTABVUE 8 (“[B]ecause Applicant sells a themed tobacco product, Applicant is restricted by federal, state, and municipal law in how it can advertise and promote its e-Liquid.”)).

television, radio,<sup>130</sup> nor can it sponsor events.<sup>131</sup> In addition, because Applicant's product is an e-liquid in a bottle used to fill a vape pen, Applicant does not sell its products in convenience stores.<sup>132</sup> Applicant sells its product through vape shops, smoke stores and through its distributors' websites.<sup>133</sup>

Opposer contends that MONSTER ENERGY and MONSTER beverages are sold to the same class of consumers as smoking related products.

Monster beverages bearing the MONSTER Marks are sold at the same outlets as third-party vaping products, cigars, cigarettes, and other smoking-related goods, such as at gas stations, convenience stores, and smoke and tobacco shops. The target demographic for Monster beverages bearing the MONSTER Marks and third-party vaping products, cigars, cigarettes, and other smoking-related goods are the same, and therefore MONSTER-brand products and smoking related products are often sold in the same outlets to reach this target demographic. I am aware that these consumers often use smoking-related products in conjunction with MONSTER-brand beverages. Many examples of this pairing by consumers can be seen posted on the internet. Below are true and correct copies of images posted by consumers pairing MONSTER-brand beverages with electronic cigarettes.<sup>134</sup>

The following facts demonstrate that there has been a reasonable opportunity for confusion to occur:

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<sup>130</sup> Sleiman Discovery Dep., pp. 79-81 (21 TTABVUE 86-88).

<sup>131</sup> Sleiman Discovery Dep., pp. 82 and 95 (21 TTABVUE 89).

<sup>132</sup> Sleiman Discovery Dep., p. 88 (21 TTABVUE 88 and 102).

<sup>133</sup> Sleiman Discovery Dep., p. 94 (21 TTABVUE 101).

<sup>134</sup> Sacks Testimony Decl. ¶ 30 (25 TTABVUE 14).

- The parties have been concurrently using their marks since July 2016 with no reported instances of confusion;
- Opposer’s MONSTER ENERGY and MONSTER marks are “now one of the most recognized brands in the world today.”<sup>135</sup> Likewise, Applicant is “No. 1, if not top three, in the entire US in e-liquid sales”; not on the scale of Opposer’s size;<sup>136</sup>
- There is a huge demand for Opposer’s MONSTER ENERGY and MONSTER promotional merchandise;<sup>137</sup>
- Opposer’s primary target market of young adults ages 18 to 34 years old<sup>138</sup> and Applicant’s target demographic customers are ages 21 and older who want to quit smoking.<sup>139</sup>

Opposer, on the other hand, contends that “there has been little opportunity for actual confusion because of the minimal use of Applicant’s ICE MONSTER mark.”<sup>140</sup> For the reasons set forth above, we disagree and find that the lack of any reported instances of actual confusion weighs against finding there is a likelihood of confusion.

#### **G. Conditions under which and customers to whom sales are made**

The only evidence in the record regarding the conditions under which sales are made are where the products are sold and their price. Opposer contends that

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<sup>135</sup> Sacks Testimony Decl. ¶ 29 (25 TTABVUE 13-14).

<sup>136</sup> Sleiman Discovery Dep. pp. 90 and 98 (21 TTABVUE 97 and 105).

<sup>137</sup> Sacks Testimony Decl. ¶ 19 (25 TTABVUE 9).

<sup>138</sup> Sacks Testimony Decl. ¶¶ 32-34 (25 TTABVUE 16-17).

<sup>139</sup> Sleiman Testimony Decl. ¶¶ 20 and 23 (38 TTABVUE 6-7); Applicant’s response to Opposer’s interrogatory No. 20 (14 TTABVUE 209).

<sup>140</sup> Opposer’s Brief, p. 46 (42 TTABVUE 55).

consumers exercise relatively little care when purchasing its products because they are inexpensive.<sup>141</sup>

Beverages, clothing, apparel, and accessories bearing [Opposer's] MONSTER Marks are relatively inexpensive. A 24-pack (16 oz) of Monster's energy drinks typically retails for approximately \$34. A t-shirt bearing the MONSTER Marks can sell for about \$20–\$25. A bag sells for about \$25. A cup bearing the MONSTER Marks can sell for as little as \$5. Because of the low cost of these items, consumers do not usually spend a lot of time on their purchase of clothing, beverage ware, and accessories.<sup>142</sup>

An individual can of MONSTER energy drink can cost between \$1.99 and \$3.<sup>143</sup>

Applicant's products are also relatively inexpensive. Sean Sleiman testified that the price of Applicant's products are between \$23-\$32. On Applicant's website the products cost \$27.<sup>144</sup>

As discussed above, the products are sold, inter alia, in vape/smoke shops. Based on the information in Robert Vega's testimony declaration, vape/smoke shops may be similar to convenience stores and Opposer's energy drinks are impulse purchases.

We must assess the impact of this *DuPont* factor "based 'on the least sophisticated potential purchasers'" of the goods, *Stone Lion*, 10 USPQ2d at 1163 (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB

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<sup>141</sup> Opposer's Brief, p. (42 TTABVUE 53).

<sup>142</sup> Sack's Testimony Decl. ¶ 28 (25 TTABVUE 12-13).

<sup>143</sup> 23 TTABVUE 17, 21, 26, 31, 35 (2 for \$4.29 or 3 for \$5.79), 36, 40, 46 (2 for \$6), and 47.

<sup>144</sup> Sleiman Discovery Dep., p. 126 (21 TTABVUE 133); *see also* Sleiman Testimony Decl. ¶ 55 (38 TTABVUE 11) ("[T]he retail price range at a smoke shop or vape shop for a single ICE MONSTER e-Liquid bottle ranges from \$22 to \$32.").

2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB Jan. 22, 2014)), and there is no evidence that the least sophisticated potential purchaser of Applicant's e-liquids and Opposer's energy drinks will exercise anything more than ordinary care in purchasing.

In view of the fact that the products are relatively inexpensive and are sold in vape/smoke shops akin to convenience stores, we find this *DuPont* weighs slightly in favor of finding a likelihood of confusion.

#### H. Applicant's intent

Opposer asserts that Applicant adopted its ICE MONSTER mark in bad faith because Applicant was aware of Opposer's MONSTER ENERGY and MONSTER marks. *See, e.g., J & J Snack Foods*, 18 USPQ2d at 1891 ("Whether there is evidence of intent to trade on the goodwill of another is a factor to be considered."); *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628, 1630 (Fed. Cir. 1988) ("proof of intent to trade on another's goodwill" can provide "persuasive evidence of likelihood of confusion") (citation omitted).

Applicant has shown an intent to deliberately create a likelihood of confusion with [Opposer's] MONSTER Marks. Applicant has admitted that not only was it familiar with [Opposer's] MONSTER Marks before it selected and began using Applicant's ICE MONSTER Mark, but Applicant ***internally discussed a possible trademark dispute with Monster***.<sup>145</sup> When Applicant selected its

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<sup>145</sup> Sleiman Discovery Dep., p. 17 (21 TTABVUE 24) (knew about MONSTER ENERGY drinks while in college); p. 34 (21 TTABVUE 34) (when considering filing the ICE MONSTER application Sleiman and his partner discussed hearing that Opposer thinks it owns the word "Monster," and that Opposer might make a stink about the ICE MONSTER application, because Opposer thinks something that is not true.).

ICE MONSTER Mark, Applicant had a duty to avoid similarities with Monster's famous MONSTER Marks. Though Applicant was aware of at least some of [Opposer's] MONSTER Marks, Applicant proceeded to use its ICE MONSTER Mark anyway, without any further investigation.

Given that Applicant specifically considered that [Opposer] might object to Applicant's Application and marched ahead with its filing anyway, it is reasonable to conclude that Applicant adopted the ICE MONSTER mark in bad faith.<sup>146</sup> (Emphasis added)(Internal citations omitted).

We do not infer that Applicant intended to create a likelihood of confusion with Opposer's MONSTER and MONSTER ENERGY marks simply because Applicant was aware of Opposer's marks. "[A]n inference of 'bad faith' requires something more than mere knowledge of a prior similar mark." *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). "A finding of bad faith must be supported by evidence of an intent to confuse, rather than mere knowledge of another's mark or even an intent to copy." *CareFusion 2200, Inc. v. Entrotech Life Sciences, Inc.*, 119 USPQ2d 1493, 1505 (TTAB 2016) (citing *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769, 1782 (2d Cir. 2009)). Establishing bad faith requires a showing that Applicant intentionally sought to trade on Opposer's good will or reputation. *See Big Blue Prod. Inc. v. IBM Corp.*, 19 USPQ2d 1072, 1076 n.5 (TTAB 1991). The record is insufficient to support Opposer's position. Thus, in this case, Applicant's mere knowledge of Opposer does not equate to bad faith. That Sleiman and his partner discussed

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<sup>146</sup> Opposer's Brief, p. 44 (42 TTABVUE 52).

whether Opposer would object to Applicant's registration of ICE MONSTER acknowledges Opposer's existence, but rejects Opposer's position.

Accordingly, Applicant's intentions in filing the subject applications are not a significant factor in our likelihood of confusion analysis.

### **I. Conclusion**

We have considered, weighed and balanced all of the arguments and evidence of record, and all relevant *DuPont* factors for which there is argument and evidence. *In re Charger Ventures*, 2023 USPQ2d 451, at \*7. The factors favoring likelihood of confusion include:

- Opposer's MONSTER and MONSTER ENERGY marks are inherently and commercially strong in connection with energy drinks, beverages, and nutritional supplements;
- the marks are similar;
- consumers exercise only ordinary care; and
- Opposer uses its marks on a wide variety of products.

The countervailing factors that weigh against finding likelihood of confusion include:

- the goods are not related;
- the goods are offered in different channels of trade; and
- there are no reported instances of actual confusion despite the opportunity of confusion to occur.

The fact that the goods are not related and that there have been no reported instances of confusion carry great weight in our analysis. *See Citigroup*, 98 USPQ2d

at 1261 (varying weights may be assigned to each *DuPont* factor depending on the evidence presented); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination.”). We find, therefore, that Applicant’s mark ICE MONSTER and design for “electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form, other than essential oils, used to refill electronic cigarette cartridges” is not likely to cause confusion with Opposer’s MONSTER and MONSTER ENERGY marks for the goods and services in connection which Opposer has registered and uses those marks.

**Decision:** We dismiss the opposition.

The parties are allowed twenty days from the mailing date of this decision to refile the Sean Sleiman discovery deposition (20 and 21 TTABVUE) redesignating as non-confidential the overdesignated information and resubmitting a properly designated redacted copy for public view, failing which the Board will make the deposition transcript publicly available.